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cont.*

301. The method of claim 151, further including the step of communicating an email confirmation of the order.

302. The method of claim 152, further including the step of communicating an email confirmation of the order.

303. The method of claim 153, further including the step of communicating an email confirmation of the order.

## II. REMARKS

Respectfully, and generally for the reasons set forth below, the objections and rejections and each ground therefor are traversed.

### A. Paragraphs of Objections and/or Rejections

#### 1. Paragraph 1 of the Office Action

In paragraph 1 of the Office Action, the Examiner has renumbered the claims.

In response, appreciation is expressed for the renumbered claims. The undersigned apologizes for any confusion caused thereby.

#### 2. Paragraph 2 of the Office Action

In paragraph 2 of the Office Action, the Examiner has objected to the drawings.

In response, it is noted that the drawings are informal, and formal drawings will be submitted timely after receipt of the Notice of Allowability.

#### 3. Paragraph 3 of the Office Action

In paragraph 3 of the Office Action, the Examiner has provided a courtesy copy of 35 U.S.C. Sec. 102(b), and no need for a response is apparent.

Applicant appreciates the Examiner's courtesy.

#### 4. Paragraph 4 of the Office Action

In paragraph 4 of the Office Action, the Examiner has rejected Claims 1-2, 22, 26-28, 31-33, and 35-37 pursuant to 35 U.S.C. Sec. 102(b). The Examiner contends that these claims are anticipated by Green.

In response, the contention is respectfully traversed as set forth below.

**5. Paragraph 5 of the Office Action**

In paragraph 5 of the Office Action, the Examiner has rejected claim 1 pursuant to 35 U.S.C. Sec. 102(b). The Examiner contends that this claim is anticipated by Green and presents citations to Green that the Examiner contends are disclosures of elements of the claims as more particularly discussed below.

In response, the contentions are traversed. Generally, and for reasons set out more particularly below, Green is directed to a front-end system (e.g., for scanning a bar code), which accordingly discloses little about any back-end system, so as to be pertinent to the instant claims. Accordingly, Green does not disclose many of the claimed features and appears to be only remotely relevant to the claimed invention.

As the undersigned understands the contentions in the Office Action, the Office Action is premised upon viewing Green's ordering terminal 10, wherein DPU RAM 34 resides, as disclosing a multitude of Applicant's claim requirements. The Examiner's attention is respectfully drawn to Applicant's Fig. 1, where Consumer Ordering System 2 is illustrated. If the undersigned correctly understands the Office Action, it is alleged that Green's terminal 10 corresponds to Applicant's System 2 (see, the ordering system set out in claim 17). Further, if the undersigned understands the Office Action correctly, it is alleged that Green's data format/transfer computer 12 corresponds to Applicant's Order Center System 26 (see, the digital computer set out in paragraph 1 of claim 1). If the Office Action is understood correctly, the Courier Shipping System 41 and Financial Institution System 33, and Distribution Center System 51 (see the shipping apparatus set out in claim 1, the charge card system set out in claim 37, the distribution center set out in claim 1, respectively) are somehow melded into Green's Fig. 1, especially items 10, 12, and 14. If the contentions of the Office Action are correctly understood, the contentions are traversed as contrary to Green. Many of Applicant's claimed features do not exist in Green, and the Office Action premise attempts to make out a case of *prima facie* obviousness by miscounting the number of computers required in Applicant's claims or disclosed in Green.

More particularly, it is noted that the preamble of claim 1 is drawn to a "method for using a digital electrical computer apparatus located at an order center for shipping a product from a remotely located distribution center, the method including the steps...." The contentions of the rejection appear to focus on apparatus, not on method

steps. For example, a citation in paragraph 5 of the Office Action to Fig. 1 shows apparatus, not method steps. See Green Col. 1, line 51, etc. Further, Fig. 1 makes no mention of the claimed step involving a distribution center nor any indication of its being remotely located from an order center for shipping a product.

Even more particularly, the Examiner contends that Green teaches the claimed method step of "producing output electrical signals representing a packing list for an order of a product by causing an order center apparatus located at an order center to change input digital electrical signals into the output digital electrical signals" at Fig. 1/10-14.

In response, the contention is respectfully traversed. This method step is not disclosed in the Fig., and further there is no mention of the claimed packing list for an order anywhere in Green. An order list is mentioned, but a packing list for the order is not mentioned. Perhaps the Examiner has confused an order with a shipment packing list: but all that is ordered is not shipped. Even further, not everything that can be ordered can be shipped—Green for example mentions using his system for snow removal. Col. 13, line 48. In any case, it makes no sense for any of the features in Fig. 1 to be generating a packing list as contended in the Office Action. Item 10 is a user device or ordering terminal, 12 is a data transfer/format central computer, and 14 is a merchant database. As there is no shipment indicated in Fig. 1 (Green being a front-end system), and there is no place in Fig 1 to have a method step pertaining to a packing list make any sense.

The Examiner also contends that Green teaches the claimed method steps of "the processor is controlled by a computer program to implement the step of producing; assigning shipping information signals to the order with a digital electrical computer shipping apparatus; linking, by digital communication, the signals representing the packing list with the shipping information signals." The Examiner relies upon Green at Col. 3, lines 27-29, and Fig. 10/130.

In response, the contention is respectfully traversed. First, the contention seems to have miscounted the number of computers in Green or in the claimed method, as generally discussed above. That is, the Examiner contends that the Green processor is controlled by a program to implement the step of producing and assigning. But the claim requires two computers for this portion of the method, the first

set out in the producing step, and the second set out in the assigning step. Thus, the contention is premised upon a miscounting of computers.

Second, no shipping apparatus or shipping signals are mentioned in Green, or any method involving the same.

Third, the cited Col. 3, lines 27-29, do not show the claimed method steps.

Fourth, the cited Fig. 10/130 does not show the claimed method steps, and indeed builds upon the above-mentioned confusion between an order list and a packing list—Fig 10 is a user screen, and the user would not need a packing list to pack something to ship to himself. Further, Fig. 10 shows "get a new blank list" and the concept of a blank packing list makes no sense. An order list is not necessarily a packing list, and it is definitely not a packing list in Green, where services like snow removal are being ordered.

Fifth, there is no teaching in Green of linking...the signals representing the packing list with the shipping information signals.

The Examiner also contends that Green teaches the claimed method steps of "transmitting the signals representing the packing list to, and receiving the signals representing the packing list at, a printer device at a distribution center located remotely from the order center." The Examiner relies upon Green at Col. 13, lines 9-19, and Fig. 10/134.

In response, the contention is respectfully traversed. First, as set out above, Green does not teach any method step involving packing list signals.

Second, as set out above, Green does not teach any method step involving shipping list signals.

Third, as set out above, Green does not teach any method step involving a distribution center, or a printer located there.

Fourth, and accordingly, Green does not indicate whether such distribution center is located remotely from such an order center.

Fifth, the cited Col. 13, lines 9-19, does not show the claimed method steps.

Sixth, the cited Fig. 10/134 does not show the claimed method steps.

The Examiner also contends that Green teaches the claimed method

steps of "printing the packing list at the printer device at the distribution center; and shipping the product specified by the packing list, in accordance with the shipping information signals, from the distribution center." The Examiner provides no location where Green makes the alleged teaching.

In response, the contention is respectfully traversed. First, as set out above, Green does not teach any method step involving a packing list or printing the same.

Second, as set out above, Green does not teach any method step involving a distribution center, or a printer (or a packing list therefrom) located there.

Third, as set out above, Green does not teach any method step involving shipping list signals. Indeed, Green does not mention shipping.

In sum, it is respectfully submitted that Green is insufficient for, and the Examiner has not set out, a case of *prima facie* anticipation for claim 1 because there are many, many features required in the claims that are not disclosed or suggested or even consistent with Green.

#### **6. Paragraph 6 of the Office Action**

In paragraph 6 of the Office Action, the Examiner has rejected claim 2 as anticipated by Green and presents citations to Green that the Examiner contends are disclosures of elements of the claims.

In response, Applicant reasserts the traversals and justifications set out with regard to base claim(s) and further reasserts that Green is insufficient for making out a case of *prima facie* anticipation, as is more particularly set forth below.

More particularly, the Examiner contends that Green teaches the claimed method step of "entering more of the input data at the input device to produce more of the output electrical signals including signals representing a customized element received from an ordering system." The Examiner relies on Col. 3, lines 39-63.

In response, the contention is respectfully traversed. This method step is not disclosed at Col. 3, lines 39-63, and further there is no mention of the claimed ...signals representing a customized element received from an ordering system.

The Examiner contends that Green teaches the claimed method step wherein "the step of linking includes linking, by digital communication, the signals

representing the packing list with the signals representing the customized element.”

The Examiner relies on Col. 3, lines 27-29.

In response, the contention is respectfully traversed, as set out above, e.g., no mention in Green of a method step involving a shipping apparatus, packing list, etc., and further that Green does not teach linking...the signals representing the packing list with the signals representing the customized element. There is no such linking in Green as there is no disclosure of such signals.

The Examiner contends that Green teaches the claimed method step wherein “the step of transmitting includes transmitting the signals representing the customized element, along with the shipping information signals, to the printer device at the distribution center.” The Examiner relies on portions of Fig. 2.

In response, the contention is respectfully traversed, as set out above, e.g., no mention in Green of a method step involving a packing list, shipping signals, distribution center, etc., and second that Green does not teach any of this portion of the claim. The portion of Green cited here in the Office Action pertains to the user’s computer (10) and has nothing to do with the claimed method step involving a printing device at a distribution center.

Third, the Examiner has made no contention whatsoever about any teaching in Green for other portions of the claim, namely that the step of printing includes printing the customized element, along with the packing list and a shipping label, at the printing device at the distribution center; and the step of shipping is carried out by shipping the customized element, along with the product, from the distribution center. Therefore, as a matter of law, a case of *prima facie* anticipation has not been made out.

In sum, it is respectfully submitted that Green is insufficient for, and the Examiner has not set out, a case of *prima facie* anticipation for claim 1 because there are many, many features required in the claims that are not disclosed or suggested or even consistent with Green.

#### **7. Paragraph 7 of the Office Action**

In paragraph 7 of the Office Action, the Examiner has rejected claim 22 as anticipated by Green and presents citations to Green that the Examiner contends are disclosures of elements of the claims.

In response, Applicant reasserts the traversals and justifications set out with regard to base claim(s) and further reasserts that Green is insufficient for making out a case of *prima facie* anticipation, as is more particularly set forth below.

More particularly, the Examiner contends that Green teaches the claimed method step of "entering more of the input data at the input device to produce more of the output electrical signals representing a customized message received from an ordering system for communication to a recipient of the product; the step of linking includes linking, by digital communication, the signals representing packing list with the signals representing the customized element; the step of transmitting includes transmitting the signals representing the customized element, along with the shipping information signals, to the printer device at the distribution center." The Examiner relies on Fig. 2, 20-24/26/30/42.

In response, the contention is respectfully traversed. This portion of the claimed method steps is not disclosed in Fig. 2, and further, first Fig. 2 shows no method step involving a customized message received from an ordering system for communication to a recipient of the product, and especially that there is no customized message, product, or recipient in the Fig. 2.

Second, there is no mention in Green of a method step involving a packing list, and further that Green does not teach linking...the signals representing the packing list with the signals representing the customized element. There is no such linking in Green as there is no such signals for the linking.

Third, the portion of Green cited here in the Office Action pertains to the user's computer (10) and has nothing to do with the claimed method step involving a printing device at a distribution center.

Fourth, Green teaches no method step involving a shipping apparatus, shipment, or shipment signals, such that a packing list would make sense.

The Examiner further contends that Col. 7, lines 1-2, Green teaches the claimed portion of the method steps wherein "the step of printing includes printing the customized element... at the printing device at the distribution center."

In response the contention is respectfully traversed. The cited portion of Green pertains to printing an order list stored within DPU RAM 34. The contention appears to have confused the ordering terminal 10, wherein DPU RAM 34 resides, with

a multitude of Applicant's claim requirements and computers. As more generally set out above, the Examiner's attention is respectfully drawn to Applicant's Fig. 1, where Consumer Ordering System 2 is illustrated. If the undersigned correctly understands the Office Action, it is alleged that Applicant's System 2 corresponds to Green's terminal 10. Further, if the undersigned understands the Office Action correctly, it is alleged that Applicant's Order Center System 26 (see the digital computer set out in paragraph 1 of claim 1) corresponds to Green's data format/transfer computer 12. Still further, if the undersigned understands the Office Action correctly, it is alleged that Applicant's Courier Shipping System 41 (see the digital electrical computer shipping apparatus set out in paragraph 2 of claim 1) corresponds somehow to Fig. 2 of Green, which is a detailed view of Green's terminal 10. Even further, if the undersigned understands the Office Action correctly, it is alleged that Applicant's Distribution Center 51 (as set out in paragraphs 4, 5, and 6 of claim 1) corresponds somehow to Fig. 2 of Green, which is a detailed view of Green's terminal 10. If the undersigned correctly understands how the Office Action has relied on Green, it is respectfully submitted that the contention has confused the ordering terminal 10 with a multitude of Applicant's claim requirements and separate computers, and is in error, self contradictory, contradictory with Green, and inadequate to make out a case of *prima facie* anticipation. Green does not teach or suggest Applicant's claimed method step of printing the customized element... at the printing device at the distribution center, etc.

The Examiner further contends that Green teaches the claimed portion of the method steps wherein "the step of printing includes printing the customized element, along with the packing list and a shipping label, at the printing device at the distribution center; and the step of shipping is carried out by shipping the customized element, along with the product, from the distribution center." The Examiner relies on Col. 12, lines 62-67, and Fig. 9/120.

In response the contention is respectfully traversed. Although Col. 12, lines 62-67, and Fig. 9/120 mention a delivery, a delivery of, say, groceries does not imply a shipment of the sort involving a shipping label, etc. as required in the claims. Green mentions groceries at Col. 13, line 39, and delivery of groceries in Green does not teach a shipping label as required in the claim. Green states that his system can be otherwise used, and lists other examples in that paragraph. Green mentions



applicability of his system to lawn mowing, snow removal, etc. which seem unworkable with a shipping label and packing list. None of the examples in Green indicate a prior art contemplation of a method of shipment with a shipping label, packing list, customized element, and a product, from a distribution center, as is more precisely required in Applicant's claims.

In view of the collective differences between Applicant's claims and Green, it is respectfully submitted that a case of *prima facie* anticipation has not been made out.

#### **8. Paragraph 8 of the Office Action**

In paragraph 8 of the Office Action, the Examiner has rejected claim 26 as anticipated by Green and presents citations to Green that the Examiner contends are disclosures of elements of the claims.

In response, Applicant reasserts the traversals and justifications set out with regard to base claim(s) and as above, and further reasserts that Green is insufficient for making out a case of *prima facie* anticipation, as is more particularly set forth below.

More particularly, the Examiner contends that Green teaches the claimed method step "wherein the step of assigning the shipping information signals includes dynamically assigning the shipping information signals through a TCP/IP connection." The Examiner relies on Col. 4, line 61-Col. 5, line 6.

In response the contention is respectfully traversed. There is no mention of the method step or a TCP/IP connection or of dynamically assigning shipping signals.

In view of the collective differences between Applicant's claims and Green, it is respectfully submitted that a case of *prima facie* anticipation has not been made out.

#### **9. Paragraph 9 of the Office Action**

In paragraph 9 of the Office Action, the Examiner has rejected claim 27 as anticipated by Green and presents citations to Green that the Examiner contends are disclosures of elements of the claims.

In response, Applicant reasserts the traversals and justifications set out with regard to base claim(s) and as above, and further reasserts that Green is

insufficient for making out a case of *prima facie* anticipation, as is more particularly set forth below.

More particularly, the Examiner contends that Green teaches the claimed method step of "prior to the step of transmitting, translating at the order center apparatus to produce the signals representing the packing list and the shipping list signals in one digital format." The Examiner relies on Col. 7, lines 7-11.

In response the contention is respectfully traversed. There is no mention of the method step or the translating or the packing list or the shipping list.

In view of the collective differences between Applicant's claims and Green, it is respectfully submitted that a case of *prima facie* anticipation has not been made out.

#### **10. Paragraph 10 of the Office Action**

In paragraph 10 of the Office Action, the Examiner has rejected claim 28 as anticipated by Green and presents citations to Green that the Examiner contends are disclosures of elements of the claims.

In response, Applicant reasserts the traversals and justifications set out with regard to base claim(s) and as above, and further reasserts that Green is insufficient for making out a case of *prima facie* anticipation, as is more particularly set forth below.

More particularly, the Examiner contends that Green teaches the claimed method step "wherein the steps of transmitting and printing are carried out with the printing device being a fax machine; and further including the step of connecting the fax machine to a communications system for the receiving of the signals representing the packing list and the shipping information signals." The Examiner relies on Col. 7, lines 1-11.

In response the contention is respectfully traversed. There is no mention here in Green of the method step or the fax machine or the packing list and the shipping information signals. Indeed, the Examiner concedes that Green does not teach any such thing involving a fax machine in Para. 34 of the Office Action: "Green fails to teach that the printing device is a fax machine...." See also Paras. 33-34 too.

In view of the collective differences between Applicant's claims and Green, it is respectfully submitted that a case of *prima facie* anticipation has not been

made out.

**11. Paragraph 11 of the Office Action**

In paragraph 11 of the Office Action, the Examiner has rejected claim 31 as anticipated by Green and presents citations to Green that the Examiner contends are disclosures of elements of the claims.

In response, Applicant reasserts the traversals and justifications set out with regard to base claim(s) and as above, and further reasserts that Green is insufficient for making out a case of *prima facie* anticipation, as is more particularly set forth below.

More particularly, the Examiner contends that Green teaches the claimed method step of "associating an order code signals with each said order at the order center apparatus." The Examiner relies on Col. 10, lines 7-15 and Fig. 5/52.

In response the contention is respectfully traversed. There is no mention of the method step, and the cited portion refers to the user's DPU 10, which Green teaches as corresponding to the user device at Col. 2, lines 53-54, which if the undersigned understands the contentions correctly, corresponds to Applicant's Consumer Ordering System 2, not the claimed method step involving associating... at the order center apparatus. The same is true for the cited Fig. 5/52.

The Examiner further contends that Green teaches the claimed method step of "obtaining shipping status information signals from the digital electrical computer shipping system." The Examiner relies on Fig. 5/52.

In response the contention is respectfully traversed. There is no mention of the method step, and the cited portion refers to the user's DPU 10, which Green teaches as corresponding to the user device at Col. 2, lines 53-54, and which (if the undersigned understands the contentions correctly) is alleged to correspond to Applicant's Consumer Ordering System 2. However, Green does not mention any digital electrical computer shipping system or shipping status information signals, and a method step involving these undisclosed features makes no sense in Green's user computer 10.

The Examiner additionally contends that Green teaches the claimed method step of "combining the order code signals with the status information signals at

a machine-readable site having a gateway address for access by an ordering system digital electrical computer." The Examiner relies on Col. 10, lines 17-28.

In response the contention is respectfully traversed. There is no mention of the method step, and no mention of a gateway address and no mention of status information signals and no mention of any method for combining them with order code signals.

In view of the collective differences between Applicant's claims and Green, it is respectfully submitted that a case of *prima facie* anticipation has not been made out.

#### **12. Paragraph 12 of the Office Action**

In paragraph 12 of the Office Action, the Examiner has rejected claim 32 as anticipated by Green and presents citations to Green that the Examiner contends, are disclosures of elements of the claims.

In response, Applicant reasserts the traversals and justifications set out with regard to base claim(s) and as above, and further reasserts that Green is insufficient for making out a case of *prima facie* anticipation, as is more particularly set forth below.

More particularly, the Examiner contends that Green teaches the claimed method step of "printing a network gateway address on packaging for the product to facilitate an electronic communication from an ordering system digital electrical computer to the order center apparatus." The Examiner relies on Col. 6, lines 57-60 and Fig. 2/42.

In response the contention is respectfully traversed. There is no mention of the method step, and no mention of a gateway address or of packaging for the product or any method step involving them.

In view of the collective differences between Applicant's claims and Green, it is respectfully submitted that a case of *prima facie* anticipation has not been made out.

#### **13. Paragraph 13 of the Office Action**

In paragraph 13 of the Office Action, the Examiner has rejected claim 33 as anticipated by Green and presents citations to Green that the Examiner contends are disclosures of elements of the claims.

In response, Applicant reasserts the traversals and justifications set out with regard to base claim(s) and as above, and further reasserts that Green is insufficient for making out a case of *prima facie* anticipation, as is more particularly set forth below.

More particularly, the Examiner contends that Green teaches the claimed method step of "making the processor electrically connected to the input device by electrically connecting the input device to an ordering system digital electrical computer and electrically connecting the ordering system digital electrical computer to a network gateway, and electrically connecting the network gateway to the processor." The Examiner relies on Col. 3, lines 21-32, Col. 4, lines 40-60, and Col. 5, lines 1-21.

In response the contention is respectfully traversed. Pursuant to the Claim 1, the order center apparatus has the processor, which is connected by the network gateway to the ordering system, pursuant to claim 33. Green instead teaches the Internet intermediate the DFTC 12 and the merchant database 14. See Col. 5, lines 7-20, i.e., see the antecedent for "communication" in line 16 of Green.

In view of the collective differences between Applicant's claims and Green, it is respectfully submitted that a case of *prima facie* anticipation has not been made out.

#### **14. Paragraph 14 of the Office Action**

In paragraph 14 of the Office Action, the Examiner has rejected claim 35 as anticipated by Green and presents citations to Green that the Examiner contends are disclosures of elements of the claims.

In response, Applicant reasserts the traversals and justifications set out with regard to base claim(s) and as above, and further reasserts that Green is insufficient for making out a case of *prima facie* anticipation, as is more particularly set forth below.

More particularly, the Examiner contends that Green teaches the claimed method step of "verifying charge card availability to pay for the product by an electrical communication from the order center apparatus to a charge card digital electrical computer system prior to shipping the product; and processing the shipping information to trigger a second electronic communication to the charge card digital electrical

computer system charging the payment to the charge card subsequent to the shipping the product." The Examiner relies on Col. 10, lines 34-52.

In response the contention is respectfully traversed. There is no mention of the method step, and no mention of a "charge card" except to say that Green's control card resembles a credit card (and thus is not a credit card) at line 38. There is no disclosure in Green of verifying charge card availability to pay for the product by an electrical communication from the order center apparatus, a charge card digital electrical computer system, processing the shipping information, a second electronic communication to the charge card digital electrical computer system charging the payment to the charge card subsequent to the shipping the product, or any method step involving them.

In view of the collective differences between Applicant's claims and Green, it is respectfully submitted that a case of *prima facie* anticipation has not been made out.

#### **15. Paragraph 15 of the Office Action**

In paragraph 15 of the Office Action, the Examiner has rejected claim 36 as anticipated by Green and presents citations to Green that the Examiner contends are disclosures of elements of the claims.

In response, Applicant reasserts the traversals and justifications set out with regard to base claim(s) and as above, and further reasserts that Green is insufficient for making out a case of *prima facie* anticipation, as is more particularly set forth below.

More particularly, the Examiner contends that Green teaches the claimed method step of "wherein the step of communicating data representing the shipping information to the digital electrical computer apparatus at the order center includes: scanning a shipping label to obtain scanning data." The Examiner relies on Col. 3, lines 7-11.

In response the contention is respectfully traversed. There is no mention of the method step, and no mention of a shipping apparatus, shipping, a shipping label scanning one, or communicating data representing the shipping information to the digital electrical computer apparatus at the order center.

The Examiner further contends that Green teaches the claimed method step of "transmitting the scanning data to the digital electrical computer apparatus at the order center for processing the shipping information to trigger the charging of the charge card." The Examiner relies on Col. 10, lines 34-52.

In response the contention is respectfully traversed. There is no mention of the method step, and no mention of a "charge card" except to say that Green's control card resembles a credit card (and thus is not a credit card) at line 38. There is no disclosure in Green of processing the shipping information to trigger the charging of the charge card.

In view of the collective differences between Applicant's claims and Green, it is respectfully submitted that a case of *prima facie* anticipation has not been made out.

**16. Paragraph 16 of the Office Action**

In paragraph 16 of the Office Action, the Examiner has rejected claim 37 as anticipated by Green and presents citations to Green that the Examiner contends are disclosures of elements of the claims.

In response, Applicant reasserts the traversals and justifications set out with regard to base claim(s) and as above, and further reasserts that Green is insufficient for making out a case of *prima facie* anticipation, as is more particularly set forth below.

More particularly, the Examiner contends that Green teaches the claimed "combination including a shipped product produced by the process of any one of the claims 1 through 36." The Examiner relies on Col. 14-line 45-Col. 20, line 52.

In response the contention is respectfully traversed. The Office Action has not made out a case of *prima facie* anticipation for any or all said base claims, and thus the instant claim cannot be anticipated. Among the multitude of claimed features not disclosed in Green as set out above, no shipping apparatus, shipment etc. as claimed has been disclosed in Green.

**17. Paragraph 17 of the Office Action**

In paragraph 17 of the Office Action, the Examiner has provided a courtesy copy of 35 U.S.C. Sec. 103(a), and no need for a response is apparent.

Applicant appreciates the Examiner's courtesy.

**18. Paragraph 18 of the Office Action**

In paragraph 18 of the Office Action, the Examiner has rejected claims 20-21, 24, 38-43, and 46 pursuant to 35 U.S.C. Sec. 103(a). The Examiner contends that these claims are obvious based on Green.

In response, the rejection is respectfully traversed, and Applicant reasserts the traversals and justifications set out with regard to base claim(s) and as above, and further reasserts that Green is insufficient for making out a case of *prima facie* obviousness, as is more particularly set forth below.

**19. Paragraph 19 of the Office Action**

In paragraph 19 of the Office Action, the Examiner has rejected claim 20 as obvious in view of Green and presents citations to Green that the Examiner contends are disclosures of elements of the claims.

In response, Applicant reasserts the traversals and justifications set out with regard to base claim(s) and as above, and further reasserts that Green is insufficient for making out a case of *prima facie* obviousness, as is more particularly set forth below.

More particularly, the Examiner contends that Green teaches the claimed method step of 1 and further "wherein the step of printing includes printing on a sheet in the printer device; and further including the step of locating demarcations on a sheet in the printer device to detach the packing list and a shipping label." The Examiner relies Col. 7, lines 1-2 and personally asserts that "It would have been obvious to one skilled in the art at the time of the invention to utilize sheets with perforations (sic). The motivation for this is ease and uniformity in tearing."

In response, the contention is respectfully traversed. It is respectfully submitted that the Patent Office cannot reject a patent by simply making up things about the prior art—evidence is required by 35 U.S.C. Sec. 101, which provides that an applicant is entitled to a patent "unless" the PTO proves otherwise – with evidence. The Examiner has provided no evidence whatsoever from the prior art to show that the motivation to tear anything from Green was in the prior art. Green teaches no method involving a packing list or a shipping label, and no method in which they would be printed on the same sheet so as to be severed. The cited Col. 7, lines 1-2 does not mention any of the claimed method, and if Green were modified as proposed by the



Office Action, DPU RAM 34, which is within the user device 10, the user would be printing a packing list and a shipping label apparently for the user to ship to himself?! If the Office Action is referring to Green's order list, then no explanation has been given as to why one would have been inclined to tear the order list into predefined pieces. Green provides no motivation or evidence to support the Office Action contention and directly contradicts it—the proposed modification makes no sense, even if the Examiner were to establish that the motivation was in the prior art. As such the proposed modification of Green is based solely on the Examiner's personal views. Evidence or the Examiner's affidavit is hereby required.

In view of the collective differences between Applicant's claims and Green, it is respectfully submitted that a case of *prima facie* obviousness has not been made out.

**20. Paragraph 20 of the Office Action**

In paragraph 20 of the Office Action, the Examiner has rejected claim 21 as obvious in view of Green and presents citations to Green that the Examiner contends are disclosures of elements of the claims.

In response, Applicant reasserts the traversals and justifications set out with regard to base claim(s) and as above, and further reasserts that Green is insufficient for making out a case of *prima facie* obviousness, as is more particularly set forth below.

More particularly, the Examiner contends that Green teaches the claimed method step "wherein the step of printing is carried out with the demarcations including perforations to detach the packing list from the shipping label." The Examiner relies Col. 7, lines 1-2 and personally asserts that "It would have been obvious to one skilled in the art at the time of the invention to include perforations on the packing list. The motivation for this is ease and uniformity in tearing."

In response, the contention is respectfully traversed. It is respectfully submitted that the Patent Office cannot reject a patent by simply making up things about the prior art—evidence is required by 35 U.S.C. Sec. 101, which provides that an applicant is entitled to a patent "unless" the PTO proves otherwise – with evidence. The Examiner has provided no evidence whatsoever from the prior art to show that the motivation to tear anything from Green was in the prior art. Green teaches no method

involving a packing list or a shipping label, and no method in which they would be printed on the same sheet so as to be severed. The cited Col. 7, lines 1-2 does not mention any of the claimed method, and if Green were modified as proposed by the Office Action, DPU RAM 34, which is within the user device 10, the user would be printing a packing list and a shipping label apparently for the user to ship to himself?! If the Office Action is referring to Green's order list, then no explanation has been given as to why one would have been inclined to tear the order list into predefined pieces. Green provides no motivation or evidence to support the Office Action contention and directly contradicts it—the proposed modification makes no sense, even if the Examiner were to establish that the motivation was in the prior art. As such the proposed modification of Green is based solely on the Examiner's personal views. Evidence or the Examiner's affidavit is hereby required.

In view of the collective differences between Applicant's claims and Green, it is respectfully submitted that a case of *prima facie* obviousness has not been made out.

**21. Paragraph 21 of the Office Action**

In paragraph 21 of the Office Action, the Examiner has rejected claim 22 as obvious in view of Green and presents citations to Green that the Examiner contends are disclosures of elements of the claims.

In response, Applicant reasserts the traversals and justifications set out with regard to base claim(s) and as above, and further reasserts that Green is insufficient for making out a case of *prima facie* obviousness, as is more particularly set forth below.

More particularly, the Examiner contends that Green teaches the claimed method step "wherein the step of printing is carried out by locating a sheet in the printer, the sheet including a greeting card for the message and having preprinted artwork and demarcations for detaching the greeting card from the packing list and the shipping label; and wherein the step of shipping includes separating the packaging list, the shipping information, and the greeting card by tearing the sheet at the demarcations." The Examiner relies Col. 7, lines 1-2 and personally asserts that "It would have been obvious to one skilled in the art at the time of the invention to include a greeting card having preprinted artwork and demarcations for detaching the greeting card from the

packing list. The motivation for this is to make the business transaction more pleasant."

In response, the contention is respectfully traversed. It is respectfully submitted that the Patent Office cannot reject a patent by simply making up things about the prior art—evidence is required by 35 U.S.C. Sec. 101, which provides that an applicant is entitled to a patent "unless" the PTO proves otherwise – with evidence. The Examiner has provided no evidence whatsoever from the prior art to show that the motivation to make the business transaction more pleasant vis-à-vis Green was in the prior art, especially by means of the method claimed by Applicant. Green teaches no method involving a greeting card, preprinted artwork, a packing list, or demarcations, and no method in which they would be printed on the same sheet so as to be severed. The cited Col. 7, lines 1-2 does not mention any of the claimed method, and if Green were modified as proposed by the Office Action, DPU RAM 34, which is within the user device 10, the user would be printing a greeting card to himself?! If the Office Action is referring to Green's order list, then no explanation has been given as to why one would have been inclined to tear the order list into predefined pieces or why one would employ a greeting card for an order list. Green provides no motivation or evidence to support the Office Action contention and directly contradicts it—the proposed modification makes no sense, even if the Examiner were to establish that the motivation was in the prior art. As such the proposed modification of Green is based solely on the Examiner's personal views. Evidence or the Examiner's affidavit is hereby required.

In view of the collective differences between Applicant's claims and Green, it is respectfully submitted that a case of *prima facie* obviousness has not been made out.

## **22. Paragraph 22 of the Office Action**

In paragraph 22 of the Office Action, the Examiner has rejected claim 38 as obvious in view of Green and presents citations to Green that the Examiner contends are disclosures of elements of the claims.

In response, Applicant reasserts the traversals and justifications set out with regard to base claim(s) and as above, and further reasserts that Green is insufficient for making out a case of *prima facie* obviousness, as is more particularly set forth below.

More particularly, the Examiner contends that Green teaches the claimed

combination "an order center apparatus located at an order center, the order center apparatus including a digital electrical computer having a processor, the processor electrically connected to a memory device for storing and retrieving operations including machine-readable signals in the memory device, to an input device for receiving input data and converting the input data into input electrical signals, to an output device for converting output electrical signals into output, the processor controlled by a computer program to the produce circuitry connections in the processor in producing the output electrical signals from the input electrical signals, including generating output signals representing an order received from a web site for a product from the input data entered at the input device and shipping information to the order;

a communications system for transmitting the electrical signals representing the packing list and the shipping information signals;

a printer device at a distribution center located remotely from the order center and from the shipping system for receiving the signals representing the packing list and for printing a packing list from the signals representing the packing list; and

packaging for the product for shipment from the distribution center according to the shipping information signals." The Examiner relies Figure 1/10-14, Col. 2, lines 55-62, Col. 3, lines 27-29, Fig. 10/130-134, Col. 13, lines 9-19,

In response, the contentions are respectfully traversed for reasons addressed above and reasserted here with equal force, e.g., no computer shipping apparatus, no packing list, no shipping information signals, and no printer device at a distribution center located remotely from the order center and from the shipping system, etc. These contentions have all been addressed above.

Further, the Examiner personally asserts that "It would have been obvious to one skilled in the art at the time of the invention to include web sites on the Internet as communication sites. The motivation for this is for wide market coverage and exposure."

In response, the contention is respectfully traversed. It is respectfully submitted that the Patent Office cannot reject a patent by simply making up things about the prior art—evidence is required by 35 U.S.C. Sec. 101, which provides that an applicant is entitled to a patent "unless" the PTO proves otherwise – with evidence. The Examiner has provided no evidence whatsoever from the prior art to show that the

motivation for wide market coverage and exposure vis-à-vis Green was in the prior art, especially by means of the combination claimed by Applicant. Green teaches nothing about an order received from a web site. Green provides no motivation or evidence to support the Office Action contention and a web site appears to be inapposite to what Green contemplates—the proposed modification makes no sense, even if the Examiner were to establish that the motivation was in the prior art. As such the proposed modification of Green is based solely on the Examiner's personal views. Evidence or the Examiner's affidavit is hereby required.

Still further, the instant claim requires "packaging for the product for shipment from the distribution center according to the shipping information signals." The Office Action makes no contention about this requirement and Green does not teach or suggest it either. Accordingly, as a matter of law, a case of *prima facie* obviousness has not been made out.

In view of the collective differences between Applicant's claims and Green, it is respectfully submitted that a case of *prima facie* obviousness has not been made out.

### **23. Paragraph 23 of the Office Action**

In paragraph 23 of the Office Action, the Examiner has rejected claim 39 as obvious in view of Green and presents citations to Green that the Examiner contends are disclosures of elements of the claims.

In response, Applicant reasserts the traversals and justifications set out with regard to base claim(s) and as above, and further reasserts that Green is insufficient for making out a case of *prima facie* obviousness, as is more particularly set forth below.

More particularly, the Examiner contends that Green teaches the claimed combination "method for making an apparatus for the method of claim 1, the method including the steps of:

providing an order center apparatus located at an order center, the order center apparatus including a digital electrical computer having a processor, the processor electrically connected to a memory device for storing and retrieving operations including machine-readable signals in the memory device, to an input device for receiving input data and converting the input data into input electrical signals, to an

output device for converting output electrical signals into output, the processor controlled by a computer program to produce circuitry connections in the processor in producing the output electrical signals from the input electrical signals, including generating output signals representing a packing list for an order of a product from the input data entered at the input device;

providing a digital electrical computer shipping system controlled by a program to assign shipping information to the order;

linking the order center apparatus and the shipping system to a communications system including the Internet for transmitting the electrical signals representing the packing list and the shipping information signals;

linking a printer device to the communications system at a distribution center located remotely from the ordering center and from the shipping system for receiving the signals representing the packing list and the shipping information signals, and for printing a packing list from the signals representing the packing list; and

shipping the product specified by the packing list, according to the shipping information signals, and from the distribution center." The Examiner relies Figure 1/10-14, Col. 2, lines 55-62, Col. 3, lines 27-29, Fig. 10/130-134, Col. 13, lines 9-19,

In response, the contentions are respectfully traversed for reasons addressed above and reasserted here with equal force, e.g., no shipping apparatus, no packing list, no shipping information signals, and no printer device at a distribution center located remotely from the order center and from the shipping system, etc. The cited contentions have been previously discussed.

Further, the Examiner personally asserts that "It would have been obvious to one skilled in the art at the time of the invention to include the Internet as a communication means. The motivation for this is for wide coverage and speed of information transfer."

In response, the contention is respectfully traversed. It is respectfully submitted that the Patent Office cannot reject a patent by simply making up things about the prior art—evidence is required by 35 U.S.C. Sec. 101, which provides that an applicant is entitled to a patent "unless" the PTO proves otherwise – with evidence. The Examiner has provided no evidence whatsoever from the prior art to show that the

motivation for wide coverage and speed of information transfer vis-à-vis Green was in the prior art, especially by means of the combination claimed by Applicant. Presumably the speed of a dedicated system, as Green appears to have contemplated for the user system 10, would have greater speed, so the motivation provided by the Examiner appears to be teaching away from the proposed modification of Green. Green teaches nothing about the Internet for transmitting the electrical signals representing the packing list and the shipping information signals. Green provides no motivation or evidence to support the Office Action contention and such Internet communications appear to be inapposite to what Green contemplates—the proposed modification makes no sense, even if the Examiner were to establish that the motivation was in the prior art. As such the proposed modification of Green is based solely on the Examiner's personal views. Evidence or the Examiner's affidavit is hereby required.

Still further, the instant claim requires "shipping the product specified by the packing list, according to the shipping information signals, and from the distribution center." The Office Action makes no contention about this requirement and Green does not teach or suggest it either. Accordingly as a matter of law a case of *prima facie* obviousness has not been made out.

In view of the collective differences between Applicant's claims and Green, it is respectfully submitted that a case of *prima facie* obviousness has not been made out.

#### **24. Paragraph 24 of the Office Action**

In paragraph 24 of the Office Action, the Examiner has rejected claim 40 as obvious in view of Green and presents citations to Green that the Examiner contends are disclosures of elements of the claims.

In response, Applicant reasserts the traversals and justifications set out with regard to base claim(s) and as above, and further reasserts that Green is insufficient for making out a case of *prima facie* obviousness, as is more particularly set forth below.

More particularly, the Examiner contends that Green teaches the claimed "The method of any one of claims 1-34, 36, 37, wherein any one of the steps of assigning shipping information signals, linking by digital communication, and transmitting the signals representing the packing list is carried out by communicating

over the Internet." The Examiner personally asserts that "It would have been obvious to one skilled in the art at the time of the invention to utilize the Internet for assigning shipping information. The motivation for this is ease and efficiency of communication."

In response, the contention is respectfully traversed. It is respectfully submitted that the Patent Office cannot reject a patent by simply making up things about the prior art—evidence is required by 35 U.S.C. Sec. 101, which provides that an applicant is entitled to a patent "unless" the PTO proves otherwise – with evidence. The Examiner has provided no evidence whatsoever from the prior art to show that the motivation for more ease and efficiency of communication vis-à-vis Green was in the prior art, especially by means of the method claimed by Applicant. Presumably the speed of a dedicated system, as Green appears to have contemplated for the user system 10, would have greater ease and efficiency, so the motivation provided by the Examiner appears to be a teaching away from the proposed modification of Green. Green teaches nothing about any assigning shipping information, let alone by means of the Internet, and especially a method wherein one of the steps of assigning shipping information signals, linking by digital communication, and transmitting the signals representing the packing list is carried out by communicating over the Internet. Green provides no motivation or evidence to support the Office Action contention and such Internet communications appear to be inapposite to what Green contemplates—the proposed modification makes no sense, even if the Examiner were to establish that the motivation was in the prior art. As such the proposed modification of Green is based solely on the Examiner's personal views. Evidence or the Examiner's affidavit is hereby required.

In view of the collective differences between Applicant's claims and Green, it is respectfully submitted that a case of *prima facie* obviousness has not been made out.

#### **25. Paragraph 25 of the Office Action**

In paragraph 25 of the Office Action, the Examiner has rejected claim 41 as obvious in view of Green and presents citations to Green that the Examiner contends are disclosures of elements of the claims.

In response, Applicant reasserts the traversals and justifications set out with regard to base claim(s) and as above, and further reasserts that Green is



insufficient for making out a case of *prima facie* obviousness, as is more particularly set forth below.

More particularly, the Examiner contends that Green teaches the claimed "method of any one of claims 1-34, 36, 37, wherein any two of the steps of assigning shipping information signals, linking by digital communication, and transmitting the signals representing the packing list is carried out by communicating over the Internet."

The Examiner personally asserts that "It would have been obvious to one skilled in the art at the time of the invention to utilize the Internet for assigning shipping information. The motivation for this is ease and efficiency of communication."

In response, the contention is respectfully traversed. It is respectfully submitted that the Patent Office cannot reject a patent by simply making up things about the prior art—evidence is required by 35 U.S.C. Sec. 101, which provides that an applicant is entitled to a patent "unless" the PTO proves otherwise – with evidence. The Examiner has provided no evidence whatsoever from the prior art to show that the motivation for ease and efficiency of communication vis-à-vis Green was in the prior art, especially by means of the method claimed by Applicant. Presumably the speed of a dedicated system, as Green appears to have contemplated for the user system 10, would have greater ease and efficiency, so the motivation provided by the Examiner appears to be a teaching away from the modification of Green. Green teaches nothing about any assigning shipping information, let alone by means of the Internet, and especially a method wherein any two of the steps of assigning shipping information signals, linking by digital communication, and transmitting the signals representing the packing list is carried out by communicating over the Internet. The Office Action does not allege any two, and relies only on one, i.e., the shipping, thereby not even setting out a *prima facie* case. Green provides no motivation or evidence to support the Office Action contention and such Internet communications appear to be inapposite to what Green contemplates—the proposed modification makes no sense, even if the Examiner were to establish that the motivation was in the prior art. As such the proposed modification of Green is based solely on the Examiner's personal views. Evidence or the Examiner's affidavit is hereby required.

In view of the collective differences between Applicant's claims and Green, it is respectfully submitted that a case of *prima facie* obviousness has not been

made out.

**26. Paragraph 26 of the Office Action**

In paragraph 26 of the Office Action, the Examiner has rejected claim 42 as obvious in view of Green and presents citations to Green that the Examiner contends are disclosures of elements of the claims.

In response, Applicant reasserts the traversals and justifications set out with regard to base claim(s) and as above, and further reasserts that Green is insufficient for making out a case of *prima facie* obviousness, as is more particularly set forth below.

More particularly, the Examiner contends that Green teaches the claimed "method of any one of claims 1-34, 36, 37, wherein all of the steps of assigning shipping information signals, linking by digital communication, and transmitting the signals representing the packing list is carried out by communicating over the Internet." The Examiner personally asserts that "It would have been obvious to one skilled in the art at the time of the invention to utilize the Internet for assigning shipping information. The motivation for this is ease and efficiency of communication."

In response, the contention is respectfully traversed. It is respectfully submitted that the Patent Office cannot reject a patent by simply making up things about the prior art—evidence is required by 35 U.S.C. Sec. 101, which provides that an applicant is entitled to a patent "unless" the PTO proves otherwise – with evidence. The Examiner has provided no evidence whatsoever from the prior art to show that the motivation for ease and efficiency of communication vis-à-vis Green was in the prior art, especially by means of the method claimed by Applicant. Presumably the speed of a dedicated system, as Green appears to have contemplated for the user system 10, would have greater ease and efficiency, so the motivation provided by the Examiner appears to be a teaching away from the modification of Green. Green teaches nothing about any assigning shipping information, let alone by means of the Internet, and especially a method of any one of claims 1-34, 36, 37, wherein all of the steps of assigning shipping information signals, linking by digital communication, and transmitting the signals representing the packing list is carried out by communicating over the Internet. The Office Action does not allege all, and relies only on one, i.e., the shipping, thereby not even setting out a *prima facie* case. Green provides no

motivation or evidence to support the Office Action contention and such Internet communications appear to be inapposite to what Green contemplates—the proposed modification makes no sense, even if the Examiner were to establish that the motivation was in the prior art. As such the proposed modification of Green is based solely on the Examiner's personal views. Evidence or the Examiner's affidavit is hereby required.

In view of the collective differences between Applicant's claims and Green, it is respectfully submitted that a case of *prima facie* obviousness has not been made out.

**27. Paragraph 27 of the Office Action**

In paragraph 27 of the Office Action, the Examiner has rejected claim 43 as obvious in view of Green and presents citations to Green that the Examiner contends are disclosures of elements of the claims.

In response, Applicant reasserts the traversals and justifications set out with regard to base claim(s) and as above, and further reasserts that Green is insufficient for making out a case of *prima facie* obviousness, as is more particularly set forth below.

More particularly, the Examiner contends that Green teaches the claimed combination "method for using a digital electrical computer apparatus located at an order center for shipping a gift and a customizable message to a recipient, the method including the steps of:

producing output electrical signals representing a gift by causing an order center apparatus located at an order center to change input digital electrical signals into the output digital electrical signals, the order center apparatus including a digital electrical computer having a programmed processor, the processor electrically connected to a memory device for storing and retrieving machine-readable signals in the memory device, to an input device for receiving input data and converting the input data into the input electrical signals, and to an output device for receiving the output electrical signals;

specifying the gift and the consumer-composed message to the recipient by electrically connecting the input device to an ordering system digital electrical computer, electrically connecting the ordering system digital electrical computer to a web site with resources for specifying the gift and for specifying the consumer-

composed message to the recipient, and electrically connecting the web site to the processor; and

shipping the gift to the recipient and communicating the consumer-composed message to the recipient." The Examiner relies Figure 1/10-14, Col. 2, lines 55-62, and Col. 3, lines 27-29.

In response, the contentions are respectfully traversed for reasons addressed above and reasserted here with equal force, e.g., no shipping, etc. Further, Green does not teach a gift or signals representative thereof nor any method of shipping the gift to the recipient and communicating the consumer-composed message to the recipient.

Further, the Examiner personally asserts that "It would have been obvious to one skilled in the art at the time of the invention to utilize web sites to specify gifts. The motivation for this is increased flexibility in tailoring the gifts."

In response, the contention is respectfully traversed. It is respectfully submitted that the Patent Office cannot reject a patent by simply making up things about the prior art—evidence is required by 35 U.S.C. Sec. 101, which provides that an applicant is entitled to a patent "unless" the PTO proves otherwise – with evidence. The Examiner has provided no evidence whatsoever from the prior art to show that the motivation for increased flexibility in tailoring the gifts vis-à-vis Green was in the prior art, especially by means of the method claimed by Applicant. Green teaches nothing about any method step of specifying the gift and the consumer-composed message to the recipient... connecting the ordering system digital electrical computer to a web site with resources for specifying the gift and for specifying the consumer-composed message to the recipient, and electrically connecting the web site to the processor; and  
shipping the gift to the recipient and communicating the consumer-composed message to the recipient. Green provides no motivation or evidence to support the Office Action contention and such Internet communications appear to be inapposite to what Green contemplates—the proposed modification makes no sense, even if the Examiner were to establish that the motivation was in the prior art. As such the proposed modification of Green is based solely on the Examiner's personal views. Evidence or the Examiner's affidavit is hereby required.

In view of the collective differences between Applicant's claims and

Green, it is respectfully submitted that a case of *prima facie* obviousness has not been made out.

**28. Paragraph 28 of the Office Action**

In paragraph 28 of the Office Action, the Examiner has rejected claim 46 as obvious in view of Green and presents citations to Green that the Examiner contends are disclosures of elements of the claims.

In response, Applicant reasserts the traversals and justifications set out with regard to base claim(s) and as above, and further reasserts that Green is insufficient for making out a case of *prima facie* obviousness, as is more particularly set forth below.

More particularly, the Examiner contends that Green teaches the claimed "wherein the step of specifying the gift and the consumer-composed message to the recipient is carried out with the web site with resources including a Blue Mountain-type greeting card and includes specifying a graphical element."

In response, the contentions are respectfully traversed for reasons addressed above and reasserted here with equal force, e.g., no shipping, graphical element, no Blue-mountain card, etc. Further, Green does not teach a gift or signals representative thereof nor any method of shipping the gift to the recipient and communicating the consumer-composed message to the recipient.

Further, the Examiner personally asserts that "It would have been obvious to one skilled in the art at the time of the invention to utilize web site to do specifying (the claim) on a web site. Furthermore it would have been obvious to one skilled in the art at the time of the invention to include a Blue Mountain type greeting card. The motivation for this is to entertain the customer and make the business experience pleasurable."

In response, the contention is respectfully traversed. It is respectfully submitted that the Patent Office cannot reject a patent by simply making up things about the prior art—evidence is required by 35 U.S.C. Sec. 101, which provides that an applicant is entitled to a patent "unless" the PTO proves otherwise – with evidence. The Examiner has provided no evidence whatsoever from the prior art to show that the motivation for entertaining the customer and making the business experience pleasurable vis-à-vis Green was in the prior art, especially by means of the method

claimed by Applicant. Green teaches nothing about any method step wherein the step of specifying the gift and the consumer-composed message to the recipient is carried out with the web site with resources including a Blue Mountain-type greeting card and includes specifying a graphical element. Green provides no motivation or evidence to support the Office Action contention and such Internet communications appear to be inapposite to what Green contemplates—the proposed modification makes no sense, even if the Examiner were to establish that the motivation was in the prior art. As such the proposed modification of Green is based solely on the Examiner's personal views. Evidence or the Examiner's affidavit is hereby required.

In view of the collective differences between Applicant's claims and Green, it is respectfully submitted that a case of *prima facie* obviousness has not been made out.

**29. Paragraph 29 of the Office Action**

In paragraph 29 of the Office Action, the Examiner has rejected claims 8-9, 12-14, 16 and 48 pursuant to 35 U.S.C. Sec. 103(a). The Examiner contends that these claims are obvious based on Green in view of Hutton and further in view of Cannon.

In response, the rejection is respectfully traversed, and Applicant reasserts the traversals and justifications set out with regard to base claim(s) and as above, and further reasserts that Green, with or without Cannon, is insufficient for making out a case of *prima facie* obviousness, as is more particularly set forth below.

**30. Paragraph 30 of the Office Action**

In paragraph 30 of the Office Action, the Examiner has rejected claim 8 as obvious in view of Green in view of Cannon and presents citations that the Examiner contends are disclosures of elements of the claims.

In response, Applicant reasserts the traversals and justifications set out with regard to base claim(s) and as above, and further reasserts that Green and/or Cannon is insufficient for making out a case of *prima facie* obviousness, as is more particularly set forth below.

More particularly, the Examiner contends that Green teaches the claimed "method of claim 7" but makes no further contention regarding claim 7, nor claim 3 from which 7 depends. Green and Cannon suggest nothing about a method step involving a

recipient of flowers or any of the other claim 7 or 3, method steps either. Accordingly, *prima facie* case of obviousness has not been made out. The Examiner concedes that Green does not teach the method of claim 7 because claim 7 depends from 3, and the Examiner states with regard to claim 3 that "Green fails to teach..." in Para 38 of the Office Action.

Even more particularly, the Examiner contends that Green teaches the claimed, method step of 7 "wherein the step of printing includes printing the customized element on a greeting card having preprinted artwork." The Examiner concedes that Green does not disclose this method step in its entirety. The Examiner relies on Cannon at Fig. 2 and Col. 7, lines 4-14. The Examiner contends that "it would have been obvious to one skilled in the art at the time of the invention to combine Green in view of Cannon to teach printing a customized element on a greeting card with preprinted artwork. The motivation for this is to utilize social expression to maximize pleasure."

In response, the contentions are respectfully traversed for reasons addressed above and reasserted here with equal force, e.g., no shipping apparatus, no packing list, no shipping information signals, no flowers, and no printer device at a distribution center located remotely from the order center and from the shipping system, etc.

Further, neither Green nor Cannon suggest combining the teachings of the respective patents together. The Examiner's proposed reason to combine -- to utilize social expression to maximize pleasure -- does not provide a plausible justification of altering Green's order list" into a greeting card. For example, Green teaches "It is further envisaged that the order list is conveyed electronically to the merchant such that the merchant is able to update the merchant's inventory control system automatically based on the order list" at Col. 13, lines 5-8. Cannon teaches that the images are image files stored in color. Col. 7, line 65-Col. 8, line 1. If Green were modified as proposed in the Office Action, the color images of Cannon would be sent to the merchant database, which presumably would crash the merchant database or whatever system would try to fit the two together. The Examiner has not explained why one would "utilize social expression to maximize pleasure" in conveying an order list to a merchant database, and it is respectfully submitted that the Office Action is selecting

unrelatable elements and attempting to stitch them together with hindsight. A proper reason to combine the patents cited has not been provided, and even if it were, many required elements are still left undisclosed in the combination.

Still further the Examiner contends that "it would have been obvious to one skilled in the art at the time of the invention to combine Green in view of Cannon to teach...." There is nothing in the cited art about teaching, and this is an improper reason to combine the cited patents.

Yet further, the contention that Cannon at Fig. 2 and Col. 7, lines 4-14, teaches printing the customized element on a greeting card having preprinted artwork is traversed. The reference is to computer database activities, not to the claimed printing the customized element on a greeting card having preprinted artwork.

In view of the collective differences between Applicant's claims and Green and/or Cannon, it is respectfully submitted that a case of *prima facie* obviousness has not been made out.

#### **31. Paragraph 31 of the Office Action**

In paragraph 31 of the Office Action, the Examiner has rejected claim 9 as obvious in view of Green in view of Cannon and presents citations to Green that the Examiner contends are disclosures of elements of the claims.

In response, Applicant reasserts the traversals and justifications set out with regard to base claim(s) and as above, and further reasserts that Green and/or Cannon is insufficient for making out a case of *prima facie* obviousness, as is more particularly set forth below.

More particularly, the Examiner contends that Green teaches the claimed "method of claim 6 but makes no further contention regarding claims 6, 5, or 3 from which 6 depends. Green and Cannon suggest nothing about a method step involving a recipient of flowers or any of the other claim 6, 5, or 3, method steps either—certainly not at the cited Col. 7, lines 1-2 of Green. The Examiner concedes that Green does not teach the method of claim 6 because claim 6 depends from 3, and the Examiner states with regard to claim 3 that "Green fails to teach..." in Para 38 of the Office Action. See also Para. 41 of the Office Action.

Even more particularly, the Examiner contends that Green teaches the claimed method step "wherein the step of printing includes printing on a sheet in the



printer device; and further including the step of locating a sheet in the printer, the sheet including a greeting card having preprinted artwork and demarcations for detaching the greeting card from the packing list and the shipping label; and wherein the step of shipping includes separating the packaging list, the shipping information, and the greeting card by tearing the sheet at the demarcations." The Examiner concedes that Green does not disclose this method step in its entirety. The Examiner relies on Cannon at Col. 7, lines 4-14, and Col. 18, lines 46-63. The Examiner contends that "it would have been obvious to one skilled in the art at the time of the invention to combine Green in view of Cannon to teach a greeting card having preprinted artwork and demarcations for detaching the greeting card from the order packing list. The motivation for this is to utilize social expression for pleasant experiences."

In response, the contentions are respectfully traversed for reasons addressed above and reasserted here with equal force, e.g., no computer shipping system, no packing list, no shipping information signals, no flowers, and no printer device at a distribution center located remotely from the order center and from the shipping system, etc.

Further, neither Green nor Cannon suggest combining the teachings of the respective patents together. The Examiner's proposed reason to combine -- utilize social expression for pleasant experiences -- does not provide a plausible justification of altering Green's order list" into a greeting card. For example, Green teaches "It is further envisaged that the order list is conveyed electronically to the merchant such that the merchant is able to update the merchant's inventory control system automatically based on the order list" at Col. 13, lines 5-8. Cannon teaches that the images are image files stored in color. Col. 7, line 65-Col. 8, line 1. If Green were modified as proposed in the Office Action, the color images of Cannon would be sent to the merchant database, which presumably would crash the merchant database or whatever system would try to fit the two together. The Examiner has not explained why one would "utilize social expression for pleasant experiences" in conveying an order list to a merchant database, and it is respectfully submitted that the Office Action is selecting unrelatable elements and attempting to stitch them together with hindsight. A proper reason to combine the patents cited has not been provided, and even if it were, many required elements are still left undisclosed in the combination.

Still further the Examiner contends that "it would have been obvious to one skilled in the art at the time of the invention to combine Green in view of Cannon to teach...." There is nothing in the cited art about teaching, and this is an improper reason to combine the cited patents.

Yet further, the contention that Cannon at Col. 7, lines 4-14, or Col. 18, lines 46-63, teaches printing the customized element on a greeting card having preprinted artwork is traversed respectfully. The reference is to computer database activities, not to the claimed printing on a sheet... including a greeting card having preprinted artwork and demarcations....

Neither Green nor Cannon teach demarcations for detaching the greeting card from the packing list and the shipping label. The Examiner's contention is personal and his affidavit is required.

Neither Green nor Cannon teach the claimed method wherein the step of shipping includes separating the packaging list, the shipping information, and the greeting card by tearing the sheet at the demarcations.

In view of the collective differences between Applicant's claims and Green and/or Cannon, it is respectfully submitted that a case of *prima facie* obviousness has not been made out.

### **32. Paragraph 32 of the Office Action**

In paragraph 32 of the Office Action, the Examiner has rejected claim 12 as obvious in view of Green in view of Cannon and presents citations to Green that the Examiner contends are disclosures of elements of the claims.

In response, Applicant reasserts the traversals and justifications set out with regard to base claim(s) and as above, and further reasserts that Green and/or Cannon is insufficient for making out a case of *prima facie* obviousness, as is more particularly set forth below.

More particularly, the Examiner contends that Green teaches the claimed method of claim 12 but makes no further contention regarding claims 3 from which 12 depends. Green and Cannon suggest nothing about a method step involving a recipient of flowers or any of the other claim 3, method steps either—certainly not at the cited Col. 6, lines 58-67 of Green. The Examiner concedes that Green does not teach the method of claim 3 because the Examiner states with regard to claim 3 that "Green

fails to teach..." in Para 38 of the Office Action.

Even more particularly, the Examiner contends that Green teaches the claimed method step "wherein the steps of transmitting and printing are carried out with the printing device being a fax machine; and further including the step of connecting the fax machine to a communications system for the receiving of the signals representing the packing list and the shipping information signals." The Examiner concedes that Green does not disclose this method step in its entirety. The Examiner relies on Cannon at Col. 18, lines 46-63. The Examiner contends that "it would have been obvious to one skilled in the art at the time of the invention to combine Green in view of Cannon to teach a fax machine as a printer for a reproduction device for cards. The motivation for this is to reduce equipment expenditure by using a fax machine as a printer in multiple modes in the social expression business."

In response, the contentions are respectfully traversed for reasons addressed above and reasserted here with equal force, e.g., no computer shipping system, no packing list, no shipping information signals, no flowers, and no printer device at a distribution center located remotely from the order center and from the shipping system, etc.

Further, neither Green nor Cannon suggest combining the teachings of the respective patents together. The Examiner's proposed reason to combine – to reduce equipment expenditure by using a fax machine as a printer in multiple modes in the social expression business – is improper. The Examiner is required to explain what is meant by the "social expression business" in the prior art, and to establish by his affidavit that it would have reduced equipment expenditure by using a fax machine as a printer in multiple modes, as the examiner contends. Further, these do not provide a plausible justification of altering Green's order list into a greeting card, or his printer into a color fax machine either. For example, Green teaches "It is further envisaged that the order list is conveyed electronically to the merchant such that the merchant is able to update the merchant's inventory control system automatically based on the order list" at Col. 13, lines 5-8. Cannon teaches that the images are image files stored in color. Col. 7, line 65-Col. 8, line 1. If Green were modified as proposed in the Office Action, the color images of Cannon would be sent to the merchant database, which presumably would crash the merchant database or whatever system would try to fit the two

together. The Examiner has not explained why one would "using a fax machine as a printer in multiple modes in the social expression business" in conveying an order list to a merchant database, and it is respectfully submitted that the Office Action is selecting unrelatable elements and attempting to stitch them together with hindsight. A proper reason to combine the patents cited has not been provided, and even if it were, many required elements are still left undisclosed in the combination.

Additionally, no proper reason has been proposed that would have led one of ordinary skill in the art to make the proposed substitution of the color fax machine of Cannon for Green's printer 42 – Green would not be faxing his order list in color to himself.

In view of the collective differences between Applicant's claims and Green and/or Cannon, it is respectfully submitted that a case of *prima facie* obviousness has not been made out.

### **33. Paragraph 33 of the Office Action**

In paragraph 33 of the Office Action, the Examiner has rejected claim 13 as obvious in view of Green in view of Cannon and presents citations to Cannon that the Examiner contends are disclosures of elements of the claims.

In response, Applicant reasserts the traversals and justifications set out with regard to base claim(s) and as above, and further reasserts that Green and/or Cannon is insufficient for making out a case of *prima facie* obviousness, as is more particularly set forth below.

More particularly, the Examiner contends that Green teaches the claimed method of claim 13 but makes no further contention regarding claims 3 from which 12 depends. The Examiner concedes that Green does not teach the method of claim 3 because the Examiner states with regard to claim 3 that "Green fails to teach..." in Para. 38 of the Office Action.

The Examiner contends that Green teaches the method of claim 12, but in paragraph 32, the Examiner concedes that Green does not teach claim 12 in its entirety. Green and Cannon suggest nothing about a method step involving a recipient of flowers or any of the other claim 3, method steps either—certainly not at the cited Col. 6, lines 58-67 of Green.

Even more particularly, the Examiner contends that Green teaches the

claimed method step "wherein the step of transmitting includes transmitting via an open end network gateway." The Examiner relies on Col. 10, lines 18-30.

In response the contention is respectfully traversed. Green says nothing about transmitting via an open end network gateway at Col. 10, lines 18-30.

Still more particularly, the Examiner concedes that Green does not teach the claimed portion of the method step of "...a remote fax server for a subsequent transmitting over the communications system to the fax machine" in its entirety. The Examiner relies on Cannon teaching transmitting order information in a standard communication as teaching the claimed requirement at Col. 17, lines 14-35. The Examiner contends that "it would have been obvious to one skilled in the art at the time of the invention to combine Green in view of Cannon to teach that the step of transmitting includes transmitting to a remote fax server for a subsequent transmitting over the communications system. The motivation for this is to transmit order information efficiently."

In response, the contentions are respectfully traversed for reasons addressed above and reasserted here with equal force, e.g., no shipping apparatus, no packing list, no shipping information signals, no flowers, and no printer device at a distribution center located remotely from the order center and from the shipping system, etc.

Further, neither Green nor Cannon suggest combining the teachings of the respective patents together. The Examiner's proposed reason to combine "to teach" the claim requirements is improper as it is motivated solely by hindsight—there is nothing about such teaching in the cited art. And as to the Examiner's other motivation – to transmit order information efficiently – this is also improper. The Examiner is required to show that it was known in the prior art to use a fax server, which is not mentioned in the cited art, to transmit order information efficiently in the context of Green or Cannon. The use of a fax machine for Green's user system 10 has previously been discussed—there is no reason why a user would use a fax or especially a fax server to communicate with himself. Explicitly contrary to the Examiner's contention, Cannon teaches that the transmission is to the card printing facility (and thus not to a fax server). Col. 17, line 34.

Cannon does not mention a fax server, and the Office Action is just

making up claim elements like a fax server from a mere suggestion of a data transmission format like ASCII. In denying a patent, evidence of the prior art is required, not conjecture—the Examiner must provide a reference or his affidavit.

Similarly, as to the contention that "it would have been obvious to one skilled in the art at the time of the invention to combine Green in view of Cannon to teach that the step of transmitting includes transmitting to a remote fax server for a subsequent transmitting over the communications system. The motivation for this is to transmit order information efficiently." Such a proposed modification of Green or Cannon is based solely on the Examiner's personal views regarding a fax server and subsequent transmitting. Evidence or the Examiner's affidavit is hereby required.

In view of the collective differences between Applicant's claims and Green and/or Cannon, it is respectfully submitted that a case of *prima facie* obviousness has not been made out.

#### **34. Paragraph 34 of the Office Action**

In paragraph 34 of the Office Action, the Examiner has rejected claim 14 as obvious in view of Green in view of Cannon and presents citations to Cannon that the Examiner contends are disclosures of elements of the claims.

In response, Applicant reasserts the traversals and justifications set out with regard to base claim(s) and as above, and further reasserts that Green and/or Cannon is insufficient for making out a case of *prima facie* obviousness, as is more particularly set forth below.

More particularly, the Examiner contends that Green teaches the claimed method of claim 12 but makes no further contention regarding claims 3 from which 12 depends. The Examiner concedes that Green does not teach the method of claim 3 because the Examiner states with regard to claim 3 that "Green fails to teach..." in Para. 38 of the Office Action. Also, in paragraph 32, the Examiner concedes that Green does not teach claim 12 in its entirety. Green and Cannon suggest nothing about a method step involving a recipient of flowers or any of the other claim 3, method steps either.

Even more particularly, the Examiner contends that Green teaches the claimed method step "wherein the step of transmitting includes transmitting to a remote fax server with a fax modem in a local calling area of the distribution center for a

subsequent transmitting to over the communications system." The Examiner relies on Col. 10, lines 18-29.

In response the contention is respectfully traversed. Green says nothing whatsoever about "transmitting includes transmitting to a remote fax server with a fax modem in a local calling area of the distribution center for a subsequent transmitting to over the communications system" at Col. 10, lines 18-30.

Still more particularly, the Examiner concedes that Green does not teach the claimed portion of the method step of "...a fax server with a fax modem" in its entirety. The Examiner relies on Cannon teaching transmitting order information in a standard communication as teaching the claimed requirement at Col. 17, lines 14-35. The Examiner contends that "it would have been obvious to one skilled in the art at the time of the invention to combine Green in view of Cannon to teach that the step of transmitting includes transmission to a remote server with a modem in the calling area of the distribution center. The motivation for this is to expedite delivery of the product.

In response, the contentions are respectfully traversed for reasons addressed above and reasserted here with equal force, e.g., no shipping apparatus, no packing list, no shipping information signals, no flowers, and no printer device at a distribution center located remotely from the order center and from the shipping system, etc.

Further, neither Green nor Cannon suggest combining the teachings of the respective patents together. Combining "to teach" the claimed invention is not a proper reason as it is suggested solely by hindsight—there is nothing about such teaching in the cited art. Further, the Examiner's proposed – to expedite delivery of the product – has not been shown to have led one to the proposed modification of Green or Cannon. The Examiner is required to show that it was known in the prior art to use a remote server with a modem in the calling area of the distribution center, which is not mentioned in the cited art, and that to do so would expedite delivery of the product as the Examiner proposes. One would think that a direct communication would be more expeditious than the Examiner's proposed approach such that the Examiner is really proposing a teaching away, albeit still without proper basis in the cited art.

The use of a fax machine for Green's user system 10 has previously been discussed—there is no reason why a user would use a fax or especially a fax

server to communicate with himself. Explicitly contrary to the Examiner's contention, Cannon teaches that the transmission is to the card printing facility (and thus not to a fax server). Col. 17, line 34.

Cannon does not mention a transmission to a remote server with a modem in the calling area of the distribution center, and the Office Action is just making up claim elements like a transmission to a remote server with a modem in the calling area of the distribution center from a mere suggestion of a data transmission format like ASCII. In denying a patent, evidence of the prior art is required, not conjecture—the Examiner must provide a reference or his affidavit.

In view of the collective differences between Applicant's claims and Green and/or Cannon, it is respectfully submitted that a case of *prima facie* obviousness has not been made out.

**35. Paragraph 35 of the Office Action**

In paragraph 35 of the Office Action, the Examiner has rejected claim 16 as obvious in view of Green in view of Cannon and presents citations to Cannon that the Examiner contends are disclosures of elements of the claims.

In response, Applicant reasserts the traversals and justifications set out with regard to base claim(s) and as above, and further reasserts that Green and/or Cannon is insufficient for making out a case of *prima facie* obviousness, as is more particularly set forth below.

More particularly, the Examiner contends that Green teaches the claimed method of claim 3 but makes no further contention regarding claim 3 from which 16 depends. The Examiner concedes that Green does not teach the method of claim 3 because the Examiner states with regard to claim 3 that "Green fails to teach..." in Para. 38 of the Office Action. Green and Cannon suggest nothing about a method step involving a recipient of flowers or any of the other claim 3, method steps either.

Even more particularly, the Examiner appears to contend that Green teaches the claimed method step "printing an network gateway address on packaging for the product to facilitate an electronic communication from an ordering system digital electrical computer to the order center apparatus." The Examiner relies on Col. 10, lines 42-52 and Fig. 15A/80, but then retracts the contention by conceding that Green does not teach this method step in its entirety. Indeed, Green does not mention



packaging.

The Examiner relies on Cannon at Col. 18, lines 7-15. The Examiner contends that Cannon there teaches "printing an address on the package to facilitate an electronic communication from an ordering system to the order center apparatus.

In response, the contention is respectfully traversed. Cannon teaches no such thing at the cited text.

The Examiner further contends that "it would have been obvious to one skilled in the art at the time of the invention to combine Green in view of Cannon to teach printing of an address on packaging for a product to facilitate electronic communication from an ordering system to the order center apparatus. The motivation for this is to expedite the delivery process.

In response, the contentions are respectfully traversed for reasons addressed above and reasserted here with equal force, e.g., no shipping apparatus, no packing list, no shipping information signals, no flowers, and no printer device at a distribution center located remotely from the order center and from the shipping system, etc.

Further, neither Green nor Cannon suggest combining the teachings of the respective patents together. Combining "to teach" the claimed invention is not a proper reason as it is suggested solely by hindsight—there is nothing about such teaching in the cited art. Further, the Examiner's proposed – to expedite the delivery process – has not been shown to have led one to the proposed modification of Green or Cannon. Indeed none of the claim has been shown in either reference.

In denying a patent, evidence of the prior art is required, and the Examiner must provide a reference or his affidavit.

In view of the collective differences between Applicant's claims and Green and/or Cannon, it is respectfully submitted that a case of *prima facie* obviousness has not been made out.

**36. Paragraph 36 of the Office Action**

In paragraph 36 of the Office Action, the Examiner has rejected claim 48 as obvious in view of Green in view of Cannon and presents citations to Cannon that the Examiner contends are disclosures of elements of the claims.

In response, Applicant reasserts the traversals and justifications set out with regard to base claim(s) and as above, and further reasserts that Green and/or Cannon is insufficient for making out a case of *prima facie* obviousness, as is more particularly set forth below.

More particularly, the Examiner contends that Green teaches the claimed method of any one of claims 43-47.

In response, the contention is respectfully traversed. The Office Action has not made out a case of *prima facie* anticipation for any or all said base claims, and thus the instant claim cannot be anticipated. Among the multitude of claimed features not disclosed in Green as set out above, no shipping apparatus, shipment etc. as claimed has been disclosed in Green or Cannon combined.

Further the Examiner relies on Green at Col. 12, lines 57-62, Fig. 14/273-274, and Fig. 5/72, but the Examiner then retracts and concedes that Green fails to cite specifically e-mail confirmation of the order.

In response, the Examiner's reliance on Col. 12, lines 57-62, Fig. 14/273-274, and Fig. 5/72 is respectfully traversed. This appears to be the ordering, and is in no way a confirmation of the order. Additionally, it is not seen how pressing an order screen button in Fig. 5/72 sends an email. The Examiner appears to have confused the order with a confirmation of the order.

The Examiner also relies on Cannon at Col. 19, lines 31-58. The Examiner contends that Cannon there teaches the step of communicating electronic confirmation of the order.

In response, the contention is respectfully traversed. There is no such teaching at the cite portion of Cannon, and if cannon were modified to provide an email confirmation at the cited portion, Cannon would be unworkable. This portion of Cannon discusses activities of the order information database, which one would not expect to be emailing itself. Further, the activities appear to concern the order itself, rather than a confirmation thereof.

The Examiner further contends that "it would have been obvious to one skilled in the art at the time of the invention to combine Green in view of Cannon to teach the communication of electronic confirmation of the order. Furthermore, it would have been obvious to one skilled in the art to utilize email as a means of communicating

confirmation. The motivation for this is for ease and expedience of confirmation.

In denying a patent, evidence of the prior art is required, and in the context of the limited relevance of the cited art, in view of the combination of undisclosed claim requirements that separate the present invention from cited art, this contention is personal, and the Examiner must provide a reference or his affidavit.

Further, neither Green nor Cannon suggest combining the teachings of the respective patents together. Combining "to teach" the claimed invention is not a proper reason as it is suggested solely by hindsight—there is nothing about such teaching in the cited art. Further, the Examiner's proposed – ease and expedience of confirmation – has not been shown to have led one to the proposed modification of Green or Cannon, which each do not contemplate any confirmation. Indeed, none of the claim has been shown in either reference.

In view of the collective differences between Applicant's claims and Green and/or Cannon, it is respectfully submitted that a case of *prima facie* obviousness has not been made out.

**37. Paragraph 37 of the Office Action**

In paragraph 37 of the Office Action, the Examiner has rejected claims 3-7, 10-11, 15, 17-19, 34, and 47 pursuant to 35 U.S.C. Sec. 103(a). The Examiner contends that these claims are obvious based on Green in view of Hutton.

In response, the rejection is respectfully traversed, and Applicant reasserts the traversals and justifications set out with regard to base claim(s) and as above, and further reasserts that Green, with or without Hutton, is insufficient for making out a case of *prima facie* obviousness, as is more particularly set forth below.

**38. Paragraph 38 of the Office Action**

In paragraph 38 of the Office Action, the Examiner has rejected claim 3 as obvious in view of Green in view of Hutton presents citations that the Examiner contends are disclosures of elements of the claims.

In response, Applicant reasserts the traversals and justifications set out with regard to base claim(s) and as above, and further reasserts that Green, with or without Hutton, is insufficient for making out a case of *prima facie* obviousness, as is more particularly set forth below.

More particularly, the Examiner appears to contend that Green teaches the claimed method "wherein the step of generating output electrical signals representing the packing list for the order of a product is carried out by using flowers as the product, such that the step of printing the packing list is carried out by printing the packing list identifying the flowers." However, the Examiner retracts and concedes that Green fails to teach that the packing list consists specifically of flowers as the product such that the step of printing the packing list is carried out by printing the packing list identifying the flowers.

In response, as set forth above, Green does not teach a packing list of any sort or any method step involving one.

The Examiner relies on Hutton at Col. 5, lines 45-53 and Fig. 7/525/535 and further contends that therein Hutton teaches a packing list consisting of floral arrangements and flowers.

In response it is respectfully submitted that nothing of the sort is disclosed there, and further that Hutton does not mention a packing list of any sort or any method step involving one.

Further, the Office Action has not made out a case of *prima facie* obviousness because among the multitude of claimed features not disclosed in Green as set out above, no shipping apparatus, shipment, etc. as claimed has been disclosed in Green or Hutton individually or combined.

The Examiner further contends that "it would have been obvious to one skilled in the art at the time of the invention to combine Green in view of Hutton to teach the step of generating output electrical signals representing the packing list for an order of flowers. The motivation for this is to show that the system may be used for perishables."

First, it is not understood how one could combine the teachings of the remote ordering system of Green and with those of the kiosk of Hutton without contradicting their respective teachings and defeating their respective purposes.

Second, Hutton explicitly teaches that this system "interacts with a floral network" (see Abstract and Fig. 3), e.g., FTD. Col. 3, line 60. At the time of the invention, subject to any evidence the Examiner wishes to provide to the contrary, FTD did not ship—instead an operator contacts a local florist, as discussed at Col. 3, line

65. This is the same prior art set out in the Applicant's background of the Invention, and the Examiner's attention is respectfully drawn thereto. As such Hutton, like Green, has no shipping apparatus, no packing list, no shipping information signals, and no printer device at a distribution center located remotely from the order center and from the shipping system, etc.

Third, as to the Examiner's contention that "it would have been obvious to one skilled in the art at the time of the invention to combine Green in view of Hutton to teach the step of generating output electrical signals representing the packing list for an order of flowers. The motivation for this is to show that the system may be used for perishables," evidence of the prior art is required. In the context of the limited relevance of the cited art, in view of the combination of undisclosed claim requirements that separate the present invention from cited art, this contention is personal, and the Examiner must provide a reference or his affidavit.

Fourth, neither Green nor Hutton suggest combining the teachings of the respective patents together. Combining "to teach" the claimed invention is not a proper reason as it is suggested solely by hindsight—there is nothing about such teaching in the cited art. Further, the Examiner's proposed – to show that the system may be used for perishables – no explanation is offered of what system the Examiner is referring to, and why was it in the prior art to show that it could so be used? Further, the motivation has not been shown to have led one to the proposed modification of Green or Hutton, which each do not contemplate any of the method. Indeed, none of the claim has been shown in either reference.

In view of the collective differences between Applicant's claims and Green and/or Hutton, it is respectfully submitted that a case of *prima facie* obviousness has not been made out.

### **39. Paragraph 39 of the Office Action**

In paragraph 39 of the Office Action, the Examiner has rejected claim 4 as obvious in view of Green in view of Hutton presents citations that the Examiner contends are disclosures of elements of the claims.

In response, Applicant reasserts the traversals and justifications set out with regard to base claim(s) and as above, and further reasserts that Green, with or

without Hutton, is insufficient for making out a case of *prima facie* obviousness, as is more particularly set forth below.

More particularly, the Examiner appears to contend that Green teaches the method in claim 3 "wherein the step of generating output electrical signals representing the packing list for the order of a product is carried out by using flowers as the product, such that the step of printing the packing list is carried out by printing the packing list identifying the flowers." The Examiner cites to Col. 3, lines 54-55. However, the Examiner retracts and concedes that Green fails to teach that the packing list comprises flowers grown at a distribution center.

In response, Green does not teach a packing list of any sort or any method step involving one. Green also does not teach or suggest the claimed growing the flowers at the distribution center, and indeed has nothing to do with growing flowers.

The Examiner relies on Hutton at Fig. 3/27 and further contends that therein Hutton teaches growing the flowers at the distribution center.

In response it is respectfully submitted that nothing of the sort is disclosed there, and further that Hutton does not mention or suggest growing the flowers at the distribution center. Still further this makes no sense—why would FTD grow flowers at its location when it uses an operator to call a florist to get the flowers, as discussed above—the Examiner has provided no explanation.

Further, the Office Action has not made out a case of *prima facie* obviousness because among the multitude of claimed features not disclosed in Green as set out above, no shipping apparatus, shipment, etc. as claimed has been disclosed in Green or Hutton individually or combined.

The Examiner further contends that "it would have been obvious to one skilled in the art at the time of the invention to combine Green in view of Hutton to teach the step of ordering a list of flowers grown at a distribution center. The motivation for this is to eliminate shipping and purchase costs."

First, it is not understood how one could combine the teachings of the remote ordering system of Green and with those of the kiosk of Hutton without contradicting their respective teachings and defeating their respective purposes.

Second, Hutton explicitly teaches that this system "interacts with a floral network" (see Abstract and Fig. 3), e.g., FTD. Col. 3, line 60. At the time of the

invention, subject to any evidence the Examiner wishes to provide to the contrary, FTD did not ship—instead an operator contacts a local florist, as discussed at Col. 3, line 65. This is the same prior art set out in the Applicant's background of the Invention, and the Examiner's attention is respectfully drawn thereto. As such Hutton, like Green, has no shipping apparatus, no packing list, no shipping information signals, and no printer device at a distribution center located remotely from the order center and from the shipping system, etc.

Third, as to the Examiner's contention that "it would have been obvious to one skilled in the art at the time of the invention to combine Green in view of Hutton to teach the step of ordering a list of flowers grown at a distribution center. The motivation for this is to eliminate shipping and purchase costs," evidence of the prior art is required. In the context of the limited relevance of the cited art, in view of the combination of undisclosed claim requirements that separate the present invention from cited art, this contention is personal, and the Examiner must provide a reference or his affidavit.

Fourth, neither Green nor Hutton suggest combining the teachings of the respective patents together. Combining "to teach" the claimed invention is not a proper reason as it is suggested solely by hindsight—there is nothing about such teaching in the cited art. Further, the Examiner's proposed – to eliminate shipping and purchase costs – has not been shown to have been known in the prior art. Further, the motivation has not been shown to have led one to the proposed modification of Green or Hutton, which each do not contemplate any of the method. Indeed, none of the claim has been shown in either reference.

In view of the collective differences between Applicant's claims and Green and/or Hutton, it is respectfully submitted that a case of *prima facie* obviousness has not been made out.

#### **40. Paragraph 40 of the Office Action**

In paragraph 40 of the Office Action, the Examiner has rejected claim 5 as obvious in view of Green in view of Hutton presents citations that the Examiner contends are disclosures of elements of the claims.

In response, Applicant reasserts the traversals and justifications set out with regard to base claim(s) and as above, and further reasserts that Green, with or

without Hutton, is insufficient for making out a case of *prima facie* obviousness, as is more particularly set forth below.

More particularly, the Examiner appears to contend that Green teaches the method in claim 3 "wherein the step of generating output electrical signals representing the packing list for the order of a product is carried out by using flowers as the product, such that the step of printing the packing list is carried out by printing the packing list identifying the flowers." However, as previously noted the Examiner has conceded that in fact Green does not teach claim 3 in Para 38, for example, where for example the Examiner retracts and concedes that Green fails to teach that the packing list comprises flowers grown at a distribution center.

In response, Green does not teach a packing list of any sort or any method step involving one. Green also does not teach or suggest the claimed growing the flowers at the distribution center, and indeed has nothing to do with growing flowers.

The Examiner further contends that Green teaches printing the processed order on a sheet in the printer device at Col. 7, lines 1-2.

In response, the contention is respectfully traversed. There is no such teaching at the contended location.

Further, the Examiner concedes that Green does not teach the step of locating demarcations on the sheet in the printer device to detach the packing list from a shipping label.

In response, the concession is acknowledged. There would be no need for such demarcations as Green does not teach a shipping label either, and this has been discussed above and is reasserted here with equal force.

Further, the Office Action has not made out a case of *prima facie* obviousness because among the multitude of claimed features not disclosed in Green as set out above, no shipping apparatus, shipment, etc. as claimed has been disclosed in Green or Hutton individually or combined.

The Examiner further contends that "it would have been obvious to one skilled in the art at the time of the invention to utilize sheets with demarcations to enable detachment of the packing list from a shipping label. The motivation for this is to improve work efficiency."



In response, first, the contention is respectfully traversed. It is respectfully submitted that the Patent Office cannot reject a patent by simply making up things about the prior art—evidence is required by 35 U.S.C. Sec. 101, which provides that an applicant is entitled to a patent "unless" the PTO proves otherwise – with evidence. The Examiner has provided no evidence whatsoever from the prior art to show that the immediately above-quoted contention was in the prior art. As such the proposed modification of Green and/or Hutton is based solely on the Examiner's personal views. Evidence or the Examiner's affidavit is hereby required.

Second, it is not understood how one could combine the teachings of the remote ordering system of Green and with those of the kiosk of Hutton without contradicting their respective teachings and defeating their respective purposes.

Third, Hutton, like Green, has no shipping apparatus, no packing list, no shipping information signals, and no printer device at a distribution center located remotely from the order center and from the shipping system, etc.

In view of the collective differences between Applicant's claims and Green and/or Hutton, it is respectfully submitted that a case of *prima facie* obviousness has not been made out.

#### **41. Paragraph 41 of the Office Action**

In paragraph 41 of the Office Action, the Examiner has rejected claim 6 as obvious in view of Green in view of Hutton presents citations that the Examiner contends are disclosures of elements of the claims.

In response, Applicant reasserts the traversals and justifications set out with regard to base claim(s) and as above, and further reasserts that Green, with or without Hutton, is insufficient for making out a case of *prima facie* obviousness, as is more particularly set forth below.

Adding to what has been stated with regard to the contentions of claim 5 (the response to which is reasserted here), the Examiner concedes that Green does not teach that the sheet includes perforations and further contends that "it would have been obvious to one skilled in the art at the time of the invention to utilize sheets with perforations. The motivation for this is for ease and uniformity in tearing."

In response, first, the contention is respectfully traversed. It is respectfully submitted that the Patent Office cannot reject a patent by simply making up

things about the prior art—evidence is required by 35 U.S.C. Sec. 101, which provides that an applicant is entitled to a patent “unless” the PTO proves otherwise – with evidence. The Examiner has provided no evidence whatsoever from the prior art to show that the immediately above-quoted contention was in the prior art. As such the proposed modification of Green and/or Hutton is based solely on the Examiner’s personal views. Evidence or the Examiner’s affidavit is hereby required.

In view of the collective differences between Applicant’s claims and Green and/or Hutton, it is respectfully submitted that a case of *prima facie* obviousness has not been made out.

**42. Paragraph 42 of the Office Action**

In paragraph 42 of the Office Action, the Examiner has rejected claim 7 as obvious in view of Green in view of Hutton presents citations that the Examiner contends are disclosures of elements of the claims.

In response, Applicant reasserts the traversals and justifications set out with regard to base claim(s) and as above, and further reasserts that Green, with or without Hutton, is insufficient for making out a case of *prima facie* obviousness, as is more particularly set forth below.

More particularly, the Examiner appears to contend that Green teaches the method in claim 3 “wherein the step of generating output electrical signals representing the packing list for the order of a product is carried out by using flowers as the product, such that the step of printing the packing list is carried out by printing the packing list identifying the flowers.” However, as previously noted the Examiner has conceded that in fact Green does not teach claim 3 in Para 38, for example, where for example the Examiner retracts and concedes that Green fails to teach that the packing list comprises flowers grown at a distribution center.

In response, Green does not teach a packing list of any sort or any method step involving one. Green also does not teach or suggest the claimed growing the flowers at the distribution center, and indeed has nothing to do with growing flowers.

The Examiner relies on Green at Col. 3, lines 39-63 and contends that Green there teaches a customized message received from an ordering system.

In response, the contention is respectfully traversed. There is no such

teaching at the contended location, as discussed above with respect to the base claim(s).

Further, the Examiner relies on Green at Col. 3, lines 39-63 and contends that Green there teaches "for communication to a recipient the step including linking.

In response, the contention is respectfully traversed. There is no such teaching at the contended location, as discussed above with respect to the base claim(s). Further the Examiner has misquoted the claim requirements in attempting to make a rejection.

The remainder of the Office Action contentions have all been addressed above and regarding the base claim(s) and are reasserted here.

Further, the Office Action has not made out a case of *prima facie* obviousness because among the multitude of claimed features not disclosed in Green as set out above, no shipping apparatus, shipment, etc. as claimed has been disclosed in Green or Hutton individually or combined.

Second, it is not understood how one could combine the teachings of the remote ordering system of Green and with those of the kiosk of Hutton without contradicting their respective teachings and defeating their respective purposes.

Third, Hutton, like Green, has no shipping apparatus, no packing list, no shipping information signals, and no printer device at a distribution center located remotely from the order center and from the shipping system, etc.

Fourth, neither Green nor Hutton suggest combining the teachings of the respective patents together, and none of the claim has been shown in either reference.

Fifth, there is no teaching, as alleged by the Examiner, at Col. 7, lines 1-2 of the claimed step wherein the step of printing includes printing the customized element, along with the packing list and a shipping label, at the printing device at the distribution center.

In view of the collective differences between Applicant's claims and Green and/or Hutton, it is respectfully submitted that a case of *prima facie* obviousness has not been made out.

#### **43. Paragraph 43 of the Office Action**

In paragraph 43 of the Office Action, the Examiner has rejected claim

10 as obvious in view of Green in view of Hutton presents citations that the Examiner contends are disclosures of elements of the claims.

In response, Applicant reasserts the traversals and justifications set out with regard to base claim(s) and as above, and further reasserts that Green, with or without Hutton, is insufficient for making out a case of *prima facie* obviousness, as is more particularly set forth below.

More particularly, the Examiner appears to contend that Green teaches the method in claim 3 "wherein the step of generating output electrical signals representing the packing list for the order of a product is carried out by using flowers as the product, such that the step of printing the packing list is carried out by printing the packing list identifying the flowers." However, as previously noted the Examiner has conceded that in fact Green does not teach claim 3 in Para 38, for example, where for example the Examiner retracts and concedes that Green fails to teach that the packing list comprises flowers grown at a distribution center.

In response, Green does not teach a packing list of any sort or any method step involving one. Green also does not teach or suggest the claimed growing the flowers at the distribution center, and indeed has nothing to do with growing flowers.

More particularly, the Examiner contends that Green teaches the claimed method step "wherein the step of assigning the shipping information signals includes dynamically assigning the shipping information signals through a TCP/IP connection." The Examiner relies on Col. 4, line 61-Col. 5, line 6.

In response the contention is respectfully traversed. There is no mention of the method step or a TCP/IP connection or of dynamically assigning shipping signals.

In view of the collective differences between Applicant's claims and Green and/or Hutton, it is respectfully submitted that a case of *prima facie* obviousness has not been made out.

#### **44. Paragraph 44 of the Office Action**

In paragraph 44 of the Office Action, the Examiner has rejected claim 11 as obvious in view of Green in view of Hutton presents citations that the Examiner contends are disclosures of elements of the claims.

In response, Applicant reasserts the traversals and justifications set out with regard to base claim(s) and as above, and further reasserts that Green, with or

without Hutton, is insufficient for making out a case of *prima facie* obviousness, as is more particularly set forth below.

More particularly, the Examiner appears to contend that Green teaches the method in claim 3 "wherein the step of generating output electrical signals representing the packing list for the order of a product is carried out by using flowers as the product, such that the step of printing the packing list is carried out by printing the packing list identifying the flowers." However, as previously noted the Examiner has conceded that in fact Green does not teach claim 3 in Para 38, for example, where for example the Examiner retracts and concedes that Green fails to teach that the packing list comprises flowers grown at a distribution center.

In response, Green does not teach a packing list of any sort or any method step involving one. Green also does not teach or suggest the claimed growing the flowers at the distribution center, and indeed has nothing to do with growing flowers.

The Examiner relies on Green at Col. 4, line 40-Col. 5, line 2 and contends that Green there teaches prior to the step of transmitting, translating at the order center apparatus to produce the signals representing the packing list and the shipping list in one format.

In response, the contention is respectfully traversed. There is no such teaching at the contended location in Green, as discussed above with respect to the base claim(s).

Further, the Examiner the concedes that Green fails to teach the shipping signals are compiled in digital format.

In response the concession is respectfully acknowledged. Further the Examiner has misquoted the claim requirements in attempting to make a rejection.

The Examiner further contends that "it would have been obvious to one skilled in the art at the time of the invention to employ digital communications. The motivation for this is low noise distortion in the signal train."

In response, first, the contention is respectfully traversed. It is respectfully submitted that nothing in any of the cited art or claims has anything to do with low noise distortion in the signal train. This is an improper motivation for any modification or departure from the cited art in a hindsight attempt to reconstruct the claim requirements from a piecemeal approach to the prior art.

Second, the Patent Office cannot reject a patent by simply making up things about the prior art—evidence is required by 35 U.S.C. Sec. 101, which provides that an applicant is entitled to a patent “unless” the PTO proves otherwise – with evidence. The Examiner has provided no evidence whatsoever from the prior art to show that the immediately above-quoted contention was in the prior art. As such the proposed modification of Green and/or Hutton is based solely on the Examiner’s personal views. Evidence or the Examiner’s affidavit is hereby required.

Third, the Office Action has not made out a case of *prima facie* obviousness because among the multitude of claimed features not disclosed in Green as set out above, no shipping apparatus, shipment, etc. as claimed has been disclosed in Green or Hutton individually or combined.

Fourth, it is not understood how one could combine the teachings of the remote ordering system of Green and with those of the kiosk of Hutton without contradicting their respective teachings and defeating their respective purposes.

Fifth, Hutton, like Green, has no shipping apparatus, no packing list, no shipping information signals, and no printer device at a distribution center located remotely from the order center and from the shipping system, etc.

Sixth, neither Green nor Hutton suggest combining the teachings of the respective patents together, and none of the claim has been shown in either reference.

In view of the collective differences between Applicant’s claims and Green and/or Hutton, it is respectfully submitted that a case of *prima facie* obviousness has not been made out.

#### **45. Paragraph 45 of the Office Action**

In paragraph 45 of the Office Action, the Examiner has rejected claim 15 as obvious in view of Green in view of Hutton presents citations that the Examiner contends are disclosures of elements of the claims.

In response, Applicant reasserts the traversals and justifications set out with regard to base claim(s) and as above, and further reasserts that Green, with or without Hutton, is insufficient for making out a case of *prima facie* obviousness, as is more particularly set forth below.

More particularly, the Examiner appears to contend that Green teaches the method in claim 3 “wherein the step of generating output electrical signals

representing the packing list for the order of a product is carried out by using flowers as the product, such that the step of printing the packing list is carried out by printing the packing list identifying the flowers." However, as previously noted the Examiner has conceded that in fact Green does not teach claim 3 in Para 38, for example, where for example the Examiner retracts and concedes that Green fails to teach that the packing list comprises flowers grown at a distribution center.

In response, Green does not teach a packing list of any sort or any method step involving one. Green also does not teach or suggest the claimed growing the flowers at the distribution center, and indeed has nothing to do with growing flowers.

The Examiner contends that the claimed "associating an order code signals with each said order at the order center apparatus; obtaining shipping status information signals from the digital electrical computer shipping system; and combining the order code signals with the status information signals at a machine-readable site having a network gateway address for access by an ordering system including a digital electrical computer" is shown in Green at Fig. 1/14, Col. 2, line 58-Col. 3, line 4, and Fig. 2/10-14.

In response, the contention is respectfully traversed. There is no such teaching at the contended location in Green, as discussed above with respect to the base claim(s). This is conceded by the Examiner in Para 35 of the Office Action

Second, the Office Action has not made out a case of *prima facie* obviousness because among the multitude of claimed features not disclosed in Green as set out above, no shipping apparatus, shipment, etc. as claimed has been disclosed in Green or Hutton individually or combined.

Third, it is not understood how one could combine the teachings of the remote ordering system of Green and with those of the kiosk of Hutton without contradicting their respective teachings and defeating their respective purposes.

Fourth, Hutton, like Green, has no shipping apparatus, no packing list, no shipping information signals, and no printer device at a distribution center located remotely from the order center and from the shipping system, etc.

None of the claim has been shown in either reference.

In view of the collective differences between Applicant's claims and Green and/or Hutton, it is respectfully submitted that a case of *prima facie* obviousness has not been made out.

**46. Paragraph 46 of the Office Action**

In paragraph 46 of the Office Action, the Examiner has rejected claim 17 as obvious in view of Green in view of Hutton presents citations that the Examiner contends are disclosures of elements of the claims.

In response, Applicant reasserts the traversals and justifications set out with regard to base claim(s) and as above, and further reasserts that Green, with or without Hutton, is insufficient for making out a case of *prima facie* obviousness, as is more particularly set forth below.

More particularly, the Examiner appears to contend that Green teaches the method in claim 3 "wherein the step of generating output electrical signals representing the packing list for the order of a product is carried out by using flowers as the product, such that the step of printing the packing list is carried out by printing the packing list identifying the flowers." However, as previously noted the Examiner has conceded that in fact Green does not teach claim 3 in Para 38, for example, where for example the Examiner retracts and concedes that Green fails to teach that the packing list comprises flowers grown at a distribution center.

In response, Green does not teach a packing list of any sort or any method step involving one. Green also does not teach or suggest the claimed growing the flowers at the distribution center, and indeed has nothing to do with growing flowers.

The Examiner contends that the claimed "making the processor electrically connected to the input device by electrically connecting the input device to an ordering system computer, and electrically connecting the ordering system computer to a network gateway, and electrically connecting the network gateway to the processor." is shown in Green at Col. 2, lines 51-62.

In response, the contention is respectfully traversed. There is no such teaching at the contended location in Green, as discussed above with respect to the base claim(s). This is conceded by the Examiner in Para 35 of the Office Action.

Second, the Office Action has not made out a case of *prima facie* obviousness because among the multitude of claimed features not disclosed in Green



as set out above, no shipping apparatus, shipment, etc. as claimed has been disclosed in Green or Hutton individually or combined.

Third, it is not understood how one could combine the teachings of the remote ordering system of Green and with those of the kiosk of Hutton without contradicting their respective teachings and defeating their respective purposes.

Fourth, Hutton, like Green, has no shipping apparatus, no packing list, no shipping information signals, and no printer device at a distribution center located remotely from the order center and from the shipping system, etc.

None of the claim has been shown in either reference.

In view of the collective differences between Applicant's claims and Green and/or Hutton, it is respectfully submitted that a case of *prima facie* obviousness has not been made out.

**47. Paragraph 47 of the Office Action**

In paragraph 47 of the Office Action, the Examiner has rejected claim 18 as obvious in view of Green in view of Hutton presents citations that the Examiner contends are disclosures of elements of the claims.

In response, Applicant reasserts the traversals and justifications set out with regard to base claim(s) and as above, and further reasserts that Green, with or without Hutton, is insufficient for making out a case of *prima facie* obviousness, as is more particularly set forth below.

More particularly, the Examiner appears to contend that Green teaches the method in claim 3 "wherein the step of generating output electrical signals representing the packing list for the order of a product is carried out by using flowers as the product, such that the step of printing the packing list is carried out by printing the packing list identifying the flowers." However, as previously noted the Examiner has conceded that in fact Green does not teach claim 3 in Para 38, for example, where for example the Examiner retracts and concedes that Green fails to teach that the packing list comprises flowers grown at a distribution center.

In response, Green does not teach a packing list of any sort or any method step involving one. Green also does not teach or suggest the claimed growing the flowers at the distribution center, and indeed has nothing to do with growing flowers.

The Examiner contends that the claimed "providing telephones at the

order center for receiving acoustic ordering information for use as the input data" is shown in Green at Col. 13, lines 2-3.

In response, the contention is respectfully traversed. There is teaching of the method step in Green. The mention in Green to "telephonically" instead refers to a communication to the merchant. The Examiner concedes that this step is not taught in Green at Para. 49 of the Office Action.

Second, the Office Action has not made out a case of *prima facie* obviousness because among the multitude of claimed features not disclosed in Green as set out above, no shipping apparatus, shipment, etc. as claimed has been disclosed in Green or Hutton individually or combined.

Third, it is not understood how one could combine the teachings of the remote ordering system of Green and with those of the kiosk of Hutton without contradicting their respective teachings and defeating their respective purposes.

Fourth, Hutton, like Green, has no shipping apparatus, no packing list, no shipping information signals, and no printer device at a distribution center located remotely from the order center and from the shipping system, etc.

None of the claim has been shown in either reference.

In view of the collective differences between Applicant's claims and Green and/or Hutton, it is respectfully submitted that a case of *prima facie* obviousness has not been made out.

#### **48. Paragraph 48 of the Office Action**

In paragraph 48 of the Office Action, the Examiner has rejected claim 19 as obvious in view of Green in view of Hutton presents citations that the Examiner contends are disclosures of elements of the claims.

In response, Applicant reasserts the traversals and justifications set out with regard to base claim(s) and as above, and further reasserts that Green, with or without Hutton, is insufficient for making out a case of *prima facie* obviousness, as is more particularly set forth below.

The Examiner contends that Green teaches shipping the product at the distribution center at Col. 12, lines 57-59 and Fig. 14/273, 274.

In response this contention has been addressed above regarding the base claim and reasserted here with equal force. There is no such teaching in Green.

The Examiner concedes that Green does not teach production of the product at the distribution center.

In response the conceding is acknowledged.

The Examiner contends that Hutton teaches the production of the product at the distribution center.

In response it is respectfully submitted that nothing of the sort is disclosed in Hutton, and further that Hutton does not mention or suggest growing the flowers at the distribution center. Still further this makes no sense—why would FTD grow flowers at its location when it uses an operator to call a florist to get the flowers, as discussed above--the Examiner has provided no explanation.

Further, the Office Action has not made out a case of *prima facie* obviousness because among the multitude of claimed features not disclosed in Green as set out above, no shipping apparatus, shipment, etc. as claimed has been disclosed in Green or Hutton individually or combined.

The Examiner further contends that "it would have been obvious to one skilled in the art at the time of the invention to combine Green in view of Hutton to teach the idea of producing the product at the distribution center. The motivation for this minimization of cost to provide the product to the consumer."

First, it is not understood how one could combine the teachings of the remote ordering system of Green and with those of the kiosk of Hutton without contradicting their respective teachings and defeating their respective purposes.

Second, Hutton explicitly teaches that this system "interacts with a floral network" (see Abstract and Fig. 3), e.g., FTD. Col. 3, line 60. At the time of the invention, subject to any evidence the Examiner wishes to provide to the contrary, FTD did not ship—instead an operator contacts a local florist, as discussed at Col. 3, line 65. This is the same prior art set out in the Applicant's background of the Invention, and the Examiner's attention is respectfully drawn thereto. As such Hutton, like Green, has no shipping apparatus, no packing list, no shipping information signals, and no printer device at a distribution center located remotely from the order center and from the shipping system, etc.

Third, as to the Examiner's contention that "it would have been obvious to one skilled in the art at the time of the invention to combine Green in view of Hutton

to teach the idea of producing the product at the distribution center. The motivation for this minimization of cost to provide the product to the consumer," evidence of the prior art is required, not mere conjecture. In the context of the limited relevance of the cited art, in view of the combination of undisclosed claim requirements that separate the present invention from cited art, this contention is personal, and the Examiner must provide a reference or his affidavit.

Fourth, neither Green nor Hutton suggest combining the teachings of the respective patents together. Combining "to teach the idea" of the claimed invention is not a proper reason as it is suggested solely by hindsight—there is nothing about such teaching in the cited art. Further, the Examiner's proposed motivation has not been shown to have been known in the prior art, or in any way to have led one to the proposed modification of Green or Hutton, which each do not contemplate any of the method. Indeed, none of the claim has been shown in either reference.

In view of the collective differences between Applicant's claims and Green and/or Hutton, it is respectfully submitted that a case of *prima facie* obviousness has not been made out.

#### **49. Paragraph 49 of the Office Action**

In paragraph 49 of the Office Action, the Examiner has rejected claim 34 as obvious in view of Green in view of Hutton presents citations that the Examiner contends are disclosures of elements of the claims.

In response, Applicant reasserts the traversals and justifications set out with regard to base claim(s) and as above, and further reasserts that Green, with or without Hutton, is insufficient for making out a case of *prima facie* obviousness, as is more particularly set forth below.

The Examiner contends that Green teaches the method of claim 1.

In response the response of claim 1 is reasserted again with equal force here.

The Examiner does not make any contention about Claim 3, from which claim 18 depends, and as previously noted, the Examiner has conceded that in fact Green does not teach claim 3 in Para 38, for example, where for example the Examiner retracts and concedes that Green fails to teach that the packing list comprises flowers grown at a distribution center. Indeed, Green does not teach a packing list of any sort

or any method step involving one. Green also does not teach or suggest the claimed growing the flowers at the distribution center, and indeed has nothing to do with growing flowers.

The Examiner also concedes that Green does not teach the claimed providing telephones at the order center for receiving acoustic ordering information for use as the input data in its entirety.

In response the conceding is acknowledged.

The Examiner contends that Hutton teaches the billing to a charge card subsequent to shipping the product and order confirmation at Col. 6, lines 1-45.

The contention is respectfully traversed. Hutton does not mention a shipment or order confirmation, and the teaching appears to be that the billing to a charge card is done when data entry is complete. See the bottom of Col. 5. Further, if the sender is entering the data which goes to, say FTD, which then uses an operator to contact a local florist, the Examiner's interpretation of Hutton is that the sender waits by the kiosk until the local florist makes the shipment. It is respectfully submitted that this is a totally implausible interpretation of Hutton.

It is respectfully submitted that the remainder of the contentions regarding claim 34 misquote the requirements thereof, and therefore do not show obviousness. The Office Action has not made out a case of *prima facie* obviousness because among the multitude of claimed features not disclosed in Green as set out above, no shipping apparatus, shipment, etc. as claimed has been disclosed in Green or Hutton individually or combined.

First, it is not understood how one could combine the teachings of the remote ordering system of Green and with those of the kiosk of Hutton without contradicting their respective teachings and defeating their respective purposes.

Second, Hutton explicitly teaches that this system "interacts with a floral network" (see Abstract and Fig. 3), e.g., FTD. Col. 3, line 60. At the time of the invention, subject to any evidence the Examiner wishes to provide to the contrary, FTD did not ship—instead an operator contacts a local florist, as discussed at Col. 3, line 65. This is the same prior art set out in the Applicant's background of the Invention, and the Examiner's attention is respectfully drawn thereto. As such Hutton, like Green, has no shipping apparatus, no packing list, no shipping information signals, and no printer

device at a distribution center located remotely from the order center and from the shipping system, etc.

Third, as to the Examiner's contention that "it would have been obvious to one skilled in the art at the time of the invention to combine Green in view of Hutton to teach the idea of producing the product at the distribution center. The motivation for the combination requires evidence in the prior art, not mere conjecture.

Fourth, neither Green nor Hutton suggest combining the teachings of the respective patents together. Combining "to teach" the claimed invention is not a proper reason as it is suggested solely by hindsight—there is nothing about such teaching in the cited art. Further, the Examiner's proposed motivation has not been shown to have been known in the prior art, or in any way to have led one to the proposed modification of Green or Hutton, which each do not contemplate any of the method and are premised on a misquoting of claim 34. Indeed, none of the claim has been shown in either reference.

In view of the collective differences between Applicant's claims and Green and/or Hutton, it is respectfully submitted that a case of *prima facie* obviousness has not been made out.

#### **50. Paragraph 50 of the Office Action**

In paragraph 50 of the Office Action, the Examiner has rejected claim 47 as obvious in view of Green in view of Hutton presents citations that the Examiner contends are disclosures of elements of the claims.

In response, Applicant reasserts the traversals and justifications set out with regard to base claim(s) and as above, particularly in the Response concerning claim 1 and 3, and further reasserts that Green, with or without Hutton, is insufficient for making out a case of *prima facie* obviousness, as is more particularly set forth below.

The Examiner contends that Green teaches "a method for using a digital electrical computer...producing output signals representing a list of necessary intermediates of a flower arrangement...to change input signals from an Internet web page...." The Examiner relies on Fig. 1/10 and 12, Col. 2, lines 51-57.

In response the contention is respectfully traversed. Green makes no mention whatsoever about a web page, no mention whatsoever of a flower, no mention whatsoever of a flower arrangement, no mention whatsoever of intermediates, and no

mention of any method involving them. Subsequently in this Para, the Examiner appears to retract and concede the same.

The Examiner also contends that Green teaches "...producing and assigning shipping information signals to the order and linking..." The Examiner relies on Fig. 10/130 and Col. 3, lines 9-19.

In response, the response concerning claim 1 is reasserted here with equal force. Green does not teach a shipment or signals therefor. Nor is there any teaching involving linking signals representing the list with the shipping information signals.

The Examiner also contends that Green teaches "...a printer device at a distribution center located remotely from the order center ..." The Examiner relies on Fig. 10/134 and Col. 13, lines 9-19.

In response, the response concerning claim 1 is reasserted here with equal force. Green does not teach a distribution center located remotely from the order center or a printer there located.

The Examiner also contends that Green teaches "...making the delivery... as specified by the list, in accordance with the shipping information signals, from the distribution center ...".

In response, the response concerning claim 1 is reasserted here with equal force. Green does not teach any of this, and in particular does not teach the list or the shipping information signals required in the claim.

The Examiner further contends that Hutton teaches floral arrangements and flowers. The Examiner relies on Col. 5, lines 45-53 and Fig. 7/525/535.

In response the contention is respectfully traversed as this is not shown at the cited location. It is conceded that Hutton mentions flowers and floral arrangements.

The Examiner further contends that "it would have been obvious at the time of the invention to combine Green in view of Hutton to teach a set of output electrical signals representing a list of intermediates of a flower arrangement for a delivery customized for a specific recipient Furthermore it would have been obvious to one skilled in the art to utilize the Internet as a medium of communication derived from

Internet inputs. The motivation for this is to have a system accept and process orders for delivery of flowers for user requirements placed over the Internet."

In response, first, the contention is respectfully traversed. It is respectfully submitted that the Patent Office cannot reject a patent by simply making up things about the prior art—evidence is required by 35 U.S.C. Sec. 101, which provides that an applicant is entitled to a patent "unless" the PTO proves otherwise – with evidence. The Examiner has provided no evidence whatsoever from the prior art to show that the immediately above-quoted contention was in the prior art. In the context of the limited relevance of the cited art, in view of the combination of undisclosed claim requirements that separate the present invention from cited art, this contention is personal, and the Examiner must provide a reference or his affidavit.

The Office Action has not made out a case of *prima facie* obviousness, because among the multitude of claimed features not disclosed in Green and/or Hutton as set out above, no shipping information signals, no list, no shipment, no delivery center located remotely, etc. as claimed has been disclosed in Green or Hutton individually or combined.

First, it is not understood how one could combine the teachings of the remote ordering system of Green and with those of the kiosk of Hutton without contradicting their respective teachings and defeating their respective purposes.

Second, Hutton explicitly teaches that this system "interacts with a floral network" (see Abstract and Fig. 3), e.g., FTD. Col. 3, line 60. At the time of the invention, subject to any evidence the Examiner wishes to provide to the contrary, FTD did not ship—instead an operator contacts a local florist, as discussed at Col. 3, line 65. This is the same prior art set out in the Applicant's background of the Invention, and the Examiner's attention is respectfully drawn thereto. As such Hutton, like Green, has no list, no shipping information signals, and no printer device at a distribution center located remotely from the order center and from the shipping system, etc.

Third, neither Green nor Hutton suggest combining the teachings of the respective patents together. The Examiner's proposed motivation has not been shown to have been known in the prior art, or in any way to have led one to the proposed modification of Green or Hutton, which each do not contemplate any of the method and are premised on a misquoting of claim 34. Indeed, most of the claim has been shown in



either reference.

In view of the collective differences between Applicant's claims and Green and/or Hutton, it is respectfully submitted that a case of *prima facie* obviousness has not been made out.

**51. Paragraph 51 of the Office Action**

In paragraph 51 of the Office Action, the Examiner has rejected claims 23, 25, 29, 30, and 44-45 pursuant to 35 U.S.C. Sec. 103(a). The Examiner contends that these claims are obvious based on Green in view of Cannon.

In response, the rejection is respectfully traversed, and Applicant reasserts the traversals and justifications set out with regard to base claim(s) and as above, especially as concerning the response for claim 1 and for claim 8, and further reasserts that Green, with or without Cannon, is insufficient for making out a case of *prima facie* obviousness, as is more particularly set forth below.

**52. Paragraph 52 of the Office Action**

In paragraph 52 of the Office Action, the Examiner has rejected claim 23 as obvious in view of Green in view of Cannon and presents citations that the Examiner contends are disclosures of elements of the claims.

In response, Applicant reasserts the traversals and justifications set out with regard to base claim(s) and as above, and further reasserts that Green and/or Cannon is insufficient for making out a case of *prima facie* obviousness, as is more particularly set forth below.

More particularly, the Examiner contends that Green teaches the claimed method of claim 22, but appears to concede that printing an order is not synonymous with the method printing requirements of claim 1.

The Examiner concedes that Green does not teach the particular requirements of claim 23 in its entirety, and relies on Cannon at Col. 7, lines 4-14.

In response the contention is respectfully traversed. There is no such teaching at the location cited in the Office Action. Further, Cannon appears to be discussing combining database operations and not printing on a greeting card, as is more particularly set out in the claim.

The Office Action has not made out a case of *prima facie* obviousness because among the multitude of claimed features not disclosed in Green and/or

Cannon, e.g., no shipping apparatus, no packing list, no shipping information signals, and no printer device at a distribution center located remotely from the order center and from the shipping system, etc.

Further, neither Green nor Cannon suggest combining the teachings of the respective patents together. The Examiner's proposed reason to combine -- to make the social expression pleasant -- depends upon an ambiguous antecedent "the" social expression--exactly which social expression. The Examiner's proposed motivation does not provide a plausible justification of altering Green's "order list" into a greeting card. For example, Green teaches "It is further envisaged that the order list is conveyed electronically to the merchant such that the merchant is able to update the merchant's inventory control system automatically based on the order list" at Col. 13, lines 5-8. Cannon teaches that the images are image files stored in color. Col. 7, line 65-Col. 8, line 1. If Green were modified as proposed in the Office Action, the color images of Cannon would be sent to the merchant database, which presumably would crash the merchant database or whatever system would try to fit the two together. The Examiner has not explained why one would "make the social expression pleasant" in conveying an order list to a merchant database, and it is respectfully submitted that the Office Action is selecting unrelatable elements and attempting to stitch them together with hindsight. A proper reason to combine the patents cited has not been provided, and even if it were, many required elements are still left undisclosed in the combination.

In view of the collective differences between Applicant's claims and Green and/or Cannon, it is respectfully submitted that a case of *prima facie* obviousness has not been made out.

### **53 Paragraph 53 of the Office Action**

In paragraph 53 of the Office Action, the Examiner has rejected claim 25 as obvious in view of Green in view of Cannon and presents citations that the Examiner contends are disclosures of elements of the claims.

In response, Applicant reasserts the traversals and justifications set out with regard to base claim(s) and as above, and further reasserts that Green and/or Cannon is insufficient for making out a case of *prima facie* obviousness, as is more particularly set forth below.

More particularly, the Examiner contends that Green teaches the claimed

method of claim 22 and contends that Green teaches the printing on a sheet in the printer device. The Examiner relies on Col. 7, lines 1-2.

In response, the contention is respectfully traversed as not disclosed where the Examiner has cited.

The Examiner concedes that Green does not disclose the claimed method step wherein the step of printing includes printing a graphical element as part of the customized message in its entirety.

In response the conceding respectfully is acknowledged.

The Examiner contends that Cannon teaches the printing of a customized element (graphical element on a greeting card) at Col. 7, lines 26-48.

In response the contention is respectfully traversed as Cannon appears to be discussing data manipulations at the location relied upon by the Examiner, and does not teach the claimed method step wherein the step of printing includes printing a graphical element as part of the customized message.

The Office Action has not made out a case of *prima facie* obviousness because among the multitude of claimed features not disclosed in Green and/or Cannon, e.g., no shipping apparatus, no packing list, no shipping information signals, and no printer device at a distribution center located remotely from the order center and from the shipping system, etc.

The Examiner further contends that "it would have been obvious at the time of the invention to combine Green in view of Cotton to teach printing a graphical element as part of the customized message. The motivation for this is to make the printing more vivid."

In response, first, the contention is respectfully traversed. Neither Green nor Cannon suggest combining the teachings of the respective patents together. The Examiner's proposed reason to combine -- to make the printing more vivid -- has not been shown to be in the prior art and depends upon an ambiguous antecedent "the" printing—exactly what printing? The Examiner's proposed motivation does not provide a plausible justification of altering Green's "order list" into a vivid printing. For example, Green teaches "It is further envisaged that the order list is conveyed electronically to the merchant such that the merchant is able to update the merchant's inventory control system automatically based on the order list" at Col. 13, lines 5-8. Cannon teaches that

the images are image files stored in color. Col. 7, line 65-Col. 8, line 1. If Green were modified as proposed in the Office Action, the color images of Cannon would be sent to the merchant database, which presumably would crash the merchant database or whatever system would try to fit the two together. The Examiner has not explained why one would "make the printing vivid" in conveying an order list to a merchant database, and it is respectfully submitted that the Office Action is selecting unrelatable elements and attempting to stitch them together with hindsight. A proper reason to combine the patents cited has not been provided, and even if it were, many required elements are still left undisclosed in the combination.

In view of the collective differences between Applicant's claims and Green and/or Cannon, it is respectfully submitted that a case of *prima facie* obviousness has not been made out.

#### **54 Paragraph 54 of the Office Action**

In paragraph 54 of the Office Action, the Examiner has rejected claim 29 as obvious in view of Green in view of Cannon and presents citations that the Examiner contends are disclosures of elements of the claims.

In response, Applicant reasserts the traversals and justifications set out with regard to base claim(s) and as above, and further reasserts that Green and/or Cannon is insufficient for making out a case of *prima facie* obviousness, as is more particularly set forth below.

More particularly, the Examiner contends that Green teaches the claimed method of claim 28 and contends that Green teaches the claimed transmitting via a network gateway to a remote fax server for a subsequent transmitting over the communications system to the fax machine. The Examiner relies on Col. 10, lines 18-30.

In response, the contention is respectfully traversed as not disclosed where the Examiner has cited.

In response the contention is respectfully traversed. Green says nothing whatsoever about "transmitting via a network gateway to a remote fax server for a subsequent transmitting over the communications system to the fax machine" at Col. 10, lines 18-30.

The Examiner then concedes that Green fails to teach this method step

in its entirety, and the Examiner relies on Cannon at Col. 18, lines 37-45 and Fig. 21.

Cannon does not mention a fax server, and the Office Action is just making up claim elements like a fax server. In denying a patent, evidence of the prior art is required, not conjecture—the Examiner must provide a reference or his affidavit.

The Examiner contends "It would have been obvious to one skilled in the art at the time of the invention to combine Green with Cannon to teach the inclusion of a faxing operation as part of the communications structure. The motivation for this is to expand the range of receiving functions to provide multi tasking in the information transfer process."

In response the contention is respectfully traversed. Neither Green nor Cannon have anything to do with "providing multi tasking in the information transfer process" and this is no proper justification from the prior art to provide a reason to combine them. This is a personal assertion of the scope and content of the prior art by the Examiner and his affidavit or a reference is required.

No *prima facie* case of obviousness has been set out, and the contentions herein are respectfully traversed for reasons addressed above and reasserted here with equal force, e.g., no shipping apparatus, no packing list, no shipping information signals, no flowers, and no printer device at a distribution center located remotely from the order center and from the shipping system, etc.

Further, neither Green nor Cannon suggest combining the teachings of the respective patents together. The Examiner's proposed reason to combine "to teach" the claim requirements is improper as it is motivated solely by hindsight—there is nothing about such teaching in the cited art. And as to the Examiner's other motivation is also improper. The Examiner must explain the antecedent in his alleged expand the range of receiving functions to provide multi tasking in the information transfer process. The Examiner is required to show that it was known in the prior art to use a fax server, which is not mentioned in the cited art, for a legitimate reason in the prior art and in the context of Green or Cannon. The use of a fax machine for Green's user system 10 has previously been discussed—there is no reason why a user would use a fax or especially a fax server to communicate with himself. Explicitly contrary to the Examiner's contention, Cannon teaches that the transmission is to the card printing facility (and thus not to a fax server). Col. 17, line 34.

In view of the collective differences between Applicant's claims and Green and/or Cannon, it is respectfully submitted that a case of *prima facie* obviousness has not been made out.

**55 Paragraph 55 of the Office Action**

In paragraph 55 of the Office Action, the Examiner has rejected claim 30 as obvious in view of Green in view of Cannon and presents citations that the Examiner contends are disclosures of elements of the claims.

In response, Applicant reasserts the traversals and justifications set out with regard to base claim(s) and as above, and further reasserts that Green and/or Cannon is insufficient for making out a case of *prima facie* obviousness, as is more particularly set forth below.

More particularly, the Examiner contends that Green teaches the claimed method of claim 28 and contends that Green teaches the claimed transmitting to a remote fax server with a fax modem in a local calling area of the distribution center for a subsequent transmitting to over the communications system to the fax machine. The Examiner relies on Col. 10, lines 18-29.

In response, the contention is respectfully traversed as not disclosed where the Examiner has cited.

In response the contention is respectfully traversed. Green says nothing whatsoever about "transmitting to a remote fax server with a fax modem in a local calling area of the distribution center for a subsequent transmitting to over the communications system to the fax machine" at Col. 10, lines 18-30.

The Examiner then concedes that Green fails to teach this method step in its entirety, and the Examiner relies on Cannon at Col. 17, lines 14-35.

In response, this contention has been responded to above, and the response is reasserted here with equal force. Cannon does not mention transmitting to a remote fax server with a fax modem in a local calling area of the distribution center for a subsequent transmitting to over the communications system to the fax machine, and the Office Action is just making up claim elements like a fax server. In denying a patent, evidence of the prior art is required, not conjecture—the Examiner must provide a reference or his affidavit.

The Examiner contends "It would have been obvious to one skilled in the

art at the time of the invention to combine Green with Cannon to teach the inclusion of a faxing operation as part of the communications structure. The motivation for this is to expand the range of receiving functions to provide multi tasking in the information transfer process."

In response the contention is respectfully traversed. Neither Green nor Cannon have anything to do with "providing multi tasking in the information transfer process" and this is no proper justification from the prior art to provide a reason to combine them. This is a personal assertion of the scope and content of the prior art by the Examiner and his affidavit or a reference is required.

No *prima facie* case of obviousness has been set out, and the contentions herein are respectfully traversed for reasons addressed above and reasserted here with equal force, e.g., no shipping apparatus, no packing list, no shipping information signals, no flowers, and no printer device at a distribution center located remotely from the order center and from the shipping system, etc.

Further, neither Green nor Cannon suggest combining the teachings of the respective patents together. The Examiner's proposed reason to combine "to teach" the claim requirements is improper as it is motivated solely by hindsight—there is nothing about such teaching in the cited art. And as to the Examiner's other motivation is also improper. The Examiner must explain the antecedent in his alleged expand the range of receiving functions to provide multi tasking in the information transfer process. The Examiner is required to show that it was known in the prior art to use a fax server, which is not mentioned in the cited art, for a legitimate reason in the prior art and in the context of Green or Cannon. The use of a fax machine for Green's user system 10 has previously been discussed—there is no reason why a user would use a fax or especially a fax server to communicate with himself. Explicitly contrary to the Examiner's contention, Cannon teaches that the transmission is to the card printing facility (and thus not to a fax server). Col. 17, line 34.

In view of the collective differences between Applicant's claims and Green and/or Cannon, it is respectfully submitted that a case of *prima facie* obviousness has not been made out.

#### **56 Paragraph 56 of the Office Action**

In paragraph 56 of the Office Action, the Examiner has rejected claim 44

as obvious in view of Green in view of Cannon and presents citations that the Examiner contends are disclosures of elements of the claims.

In response, Applicant reasserts the traversals and justifications set out with regard to base claim(s) and as above, and further reasserts that Green and/or Cannon is insufficient for making out a case of *prima facie* obviousness, as is more particularly set forth below.

More particularly, the Examiner contends that Green teaches the claimed method of claim 43 but concedes that Green fails to teach the gift and the consumer-composed message to the recipient is carried out on the web site with resources including a Blue Mountain-type greeting card and includes a graphical element.

In response, as respectfully addressed above and reasserted here with equal force, e.g., no shipping, graphical element, no Blue-mountain card, etc. Further, Green does not teach a gift or signals representative thereof nor any method of shipping the gift to the recipient and communicating the consumer-composed message to the recipient.

The Examiner relies on Cannon for a teaching of a graphical element at Col. 7, lines 26-48

In response, the contention is respectfully traversed as not disclosed where the Examiner has cited.

The Examiner contends "It would have been obvious to one skilled in the art at the time of the invention to combine Green with Cannon to teach consumer composed message and gift on the web site including a graphical element. The motivation for this is for increased flexibility and tailoring of gifts and messages. Furthermore it would also have been obvious to one skilled in the art to include a Blue Mountain type greeting card as a specific form of graphical depiction. the motivation is to entertain the customer. "

In response the contention is respectfully traversed. Neither Green nor Cannon have anything to do with what the Examiner has contended above. This is no proper justification from the prior art to provide a reason to combine them. This is a personal assertion of the scope and content of the prior art by the Examiner and his affidavit or a reference is required.

No *prima facie* case of obviousness has been set out, and the



contentions herein are respectfully traversed for reasons addressed above and reasserted here with equal force, e.g., no shipping information signals, no gift, etc.

Further, neither Green nor Cannon suggest combining the teachings of the respective patents together. The Examiner's proposed reason to combine "to teach" the claim requirements is improper as it is motivated solely by hindsight—there is nothing about such teaching in the cited art. And as to the Examiner's other motivation is also improper. The Examiner must explain the antecedents in his allegations.

In view of the collective differences between Applicant's claims and Green and/or Cannon, it is respectfully submitted that a case of *prima facie* obviousness has not been made out.

#### **57 Paragraph 57 of the Office Action**

In paragraph 57 of the Office Action, the Examiner has rejected claim 45 as obvious in view of Green in view of Cannon and presents citations that the Examiner contends are disclosures of elements of the claims.

In response, Applicant reasserts the traversals and justifications set out with regard to base claim(s) and as above, and further reasserts that Green and/or Cannon is insufficient for making out a case of *prima facie* obviousness, as is more particularly set forth below.

More particularly, the Examiner contends that Green teaches the claimed method of claim 43 but concedes that Green fails to teach the gift and the consumer-composed message to the recipient is carried out on the web site with resources including a Blue Mountain-type greeting card and includes a graphical element.

In response, as respectfully addressed above and reasserted here with equal force, e.g., no shipping, graphical element, no Blue-mountain card, etc. Further, Green does not teach a gift or signals representative thereof nor any method of shipping the gift to the recipient and communicating the consumer-composed message to the recipient.

The Examiner relies on Cannon for a teaching of a graphical element at Col. 7, lines 26-48

In response, the contention is respectfully traversed as not disclosed where the Examiner has cited.

The Examiner contends "It would have been obvious to one skilled in the

art at the time of the invention to combine Green with Cannon to teach consumer composed message and gift on the web site including a graphical element. The motivation for this is for increased flexibility and tailoring of gifts and messages."

In response the contention is respectfully traversed. Neither Green nor Cannon have anything to do with what the Examiner has contended above. This is no proper justification from the prior art to provide a reason to combine them. This is a personal assertion of the scope and content of the prior art by the Examiner and his affidavit or a reference is required.

No *prima facie* case of obviousness has been set out, and the contentions herein are respectfully traversed for reasons addressed above and reasserted here with equal force, e.g., no shipping information signals, no gift, etc.

Further, neither Green nor Cannon suggest combining the teachings of the respective patents together. The Examiner's proposed reason to combine "to teach" the claim requirements is improper as it is motivated solely by hindsight—there is nothing about such teaching in the cited art. And as to the Examiner's other motivation is also improper. The Examiner must explain the antecedents in his allegations.

In view of the collective differences between Applicant's claims and Green and/or Cannon, it is respectfully submitted that a case of *prima facie* obviousness has not been made out.

#### **58. Paragraph 58 of the Office Action**

In paragraph 58 of the Office Action, the Examiner has set out other art made of record.

Applicant concurs that the other art does not preclude patentability.


The Examiner also has graciously provided numerous ways to communicate regarding the instant case, and the Applicant and undersigned are most appreciative. The Examiner is invited to contact the undersigned at the telephone number set out below if it can in any way expedite or facilitate issuance of a patent on the application.

#### **III. Conclusion**

The application is believed to be in condition for allowance, and favorable action is respectfully requested. Please direct all correspondence to the undersigned at the address given below.

Respectfully submitted,

Date: 24 Jan 2001

  
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